No. [redacted] 229

FILED
DEC 29 1924
WM. R. STANSBURY
CLERK

In the Supreme Court of the United States

October Term, [redacted] 1925

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The I. T. S. Rubber Company,
Petitioner,

v.

Essex Rubber Company,
Respondent.

On Petition for Writ of Certiorari Directed to the United States Circuit Court of Appeals for the Fifth Circuit.

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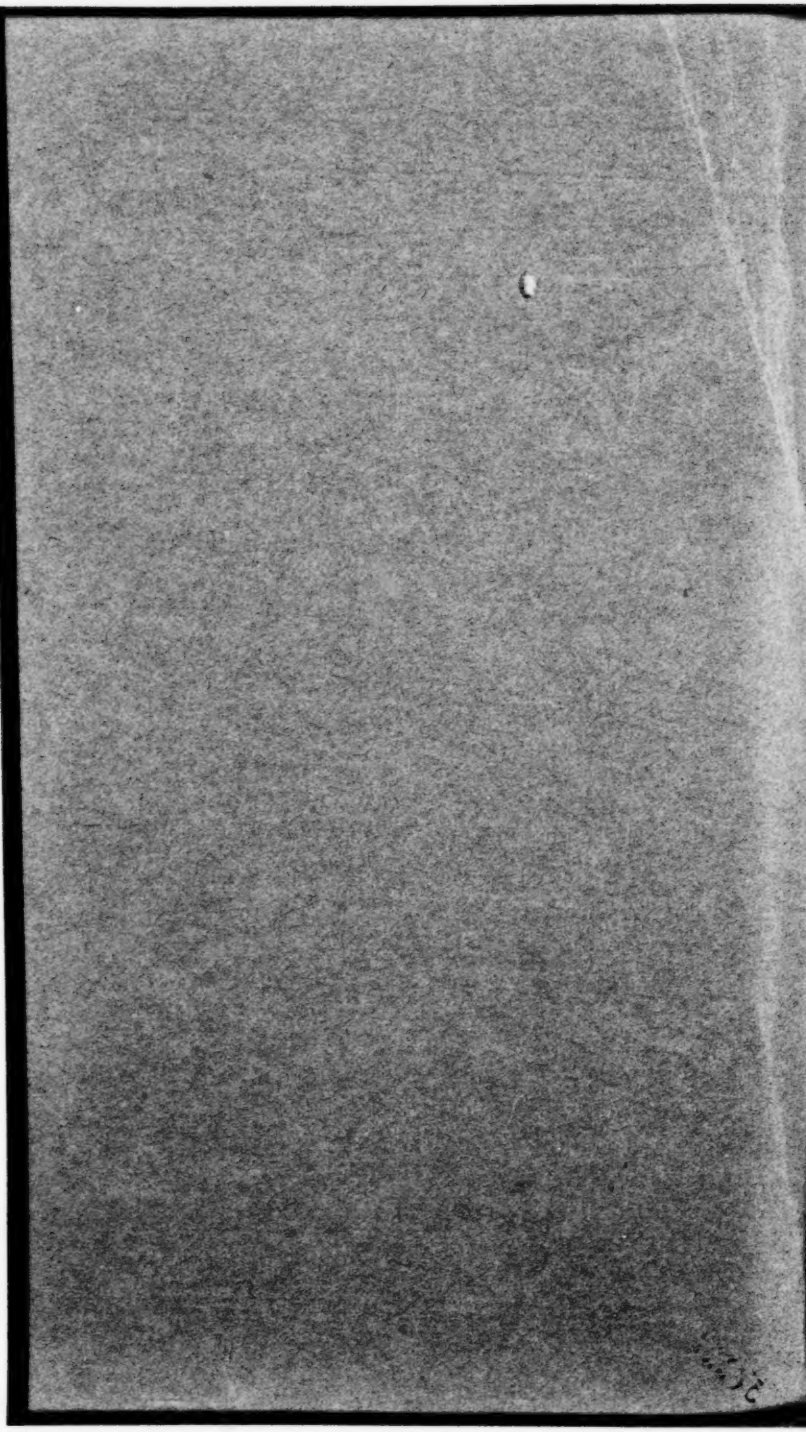

In the Supreme Court of the United States

OCTOBER TERM, 1924.

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI DIRECTED TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

PETITION FOR WRIT OF CERTIORARI
and
BRIEF IN SUPPORT THEREOF.

MELVILLE CHURCH,
CHARLES A. BROWN,
For Petitioner.

J50226

In the Supreme Court of the United States

OCTOBER TERM, 1924.

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,
Respondent.

NOTICE.

To Essex Rubber Company or Its Solicitors:

Please take notice that upon a certified copy of the transcript of record herein, we shall present the petition for writ of certiorari and the brief in support thereof, hereunto annexed, to the Supreme Court of the United States at the Capitol, in the City of Washington, District of Columbia, on January 5th, A. D. 1925, at the opening of the court on that day, or as soon thereafter as counsel can be heard.

We shall request the Clerk of the Supreme Court to make such presentation and submission for us.

MELVILLE CHURCH,
CHARLES A. BROWN,
Solicitors for Petitioner.

December 17, 1924.

To Frederick L. Emery,
Lucius E. Varney.
Counsel for Respondent.

Service accepted Dec. 17, 1924
Frederick L. Emery

Service of the foregoing Petition and Brief in the above entitled cause is admitted on this 17 day of November, 1924.

Frederick F. Emery

.....

In the Supreme Court of the United States

OCTOBER TERM, 1924.

THE I. T. S. RUBBER COMPANY,

Petitioner,

vs.

ESSEX RUBBER COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your petitioner, The I. T. S. Rubber Company, an Ohio corporation, of Elyria, Ohio, owner of the Tufford Reissue Patent No. 14,049, respectfully represents:

FIRST: The ground upon which this petition is based is a direct conflict between final decrees of Courts of Appeals for the First and Sixth Circuits with respect to the Tufford Reissue Patent No. 14, 049.

SECOND: The respondent, Essex Rubber Company, is a New Jersey corporation, and had, when the Bill was filed, a regular and established place of business in Boston, Massachusetts, where it committed the alleged infringing acts.

THIRD: The Sixth Circuit Court of Appeals held a device to infringe claims 5 to 9, inclusive, of the Tufford Reissue Patent No. 14,049. The First Circuit Court of Appeals held, what was admittedly, the same device not to infringe the same claims of the same patent. The record was substantially the same in each case.

FOURTH: Your petitioner has been aggrieved and believes a miscarriage of justice has been caused in this case, because the decisions of the Courts of Appeals in the First and Sixth Circuits are in conflict.

Your petitioner represents that in compliance with the rule of this Court, it has furnished and filed as an exhibit to this petition a certified copy of the record submitted to the Circuit Court of Appeals for the First Circuit and of the proceedings in said court.

Wherefore, your petitioner respectfully prays (1) that a writ of certiorari may be issued out of and under the seal of this Court, directed to the United States Circuit Court of Appeals for the First Circuit, commanding the said Court to certify and send to this Court on a day therein designated, a full and complete transcript of the record and all proceedings in the said Circuit Court of Appeals in the said case entitled *The I. T. S. Rubber Company vs. Essex Rubber Company No. 1642,* to the end that the said case may be reviewed and determined by this Court pursuant to the provisions of the statutes in such cases made and provided; (2) that this Court will stay the action of the Circuit Court of Appeals in the First Circuit until this proceeding is disposed of; (3) that your petitioners may have such other and further relief in the premises as the nature and circumstances of the case may require; (4) and that said judgment of the said Circuit Court of Appeals of

the First Circuit may be reversed by this Honorable Court.

And your petitioners will ever pray, etc.

THE I. T. S. RUBBER COMPANY,
MELVILLE CHURCH,
CHARLES A. BROWN,
Its Solicitors.

STATE OF ILLINOIS,
COUNTY OF COOK, ss:

CHARLES A. BROWN, being duly sworn, says that he is the solicitor and of counsel for The I. T. S. Rubber Company, the petitioner above named, and as such had personal charge for said petitioner of the case in the foregoing petition mentioned in the District Court of the United States for the District of Massachusetts, and in the United States Circuit Court of Appeals for the First Circuit; that he has read the foregoing petition by him subscribed; and that the facts therein stated are true to the best of his knowledge and belief.

CHARLES A. BROWN.

Subscribed and sworn to before me this 4th day of December, 1924.

CLAUDE A. NELSON,

(Notarial Seal) *Notary Public.*

I hereby certify that the above petition is believed by me to be well grounded in point of law and that it is not interposed for purposes of delay.

MELVILLE CHURCH.

In the Supreme Court of the United States

OCTOBER TERM, 1924.

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,
Respondent.

PETITIONER'S BRIEF ON PETITION FOR WRIT OF CERTIORARI.

FACTS: During the seven years in which this patent has been in litigation, there have been twenty decisions on the same in the four circuits in which it has been litigated. As the patent now stands adjudicated, a device twice held by the Circuit Court of Appeals in the Sixth Circuit to infringe has been held by the Circuit Court of Appeals in the First Circuit not to infringe.*

*So identically alike in function, mode of operation and material structural features were the devices adjudged by these two Courts of Appeals that counsel for defendant in the First Circuit case stated in the beginning of that case:

"We do not deny infringement by these exhibits if this Court follows the decision in the Sixth Circuit and Judge Brown's decision in Providence. We agree that the heels vary (here) as Exhibits 1 and 2 are infringements under this decision (R. p. 48)."

and

"If not, why then the Court, if it follows the decision in the Sixth Circuit, and Judge Brown, will hold these heels infringements (R. p. 48)."

and

"We admit that it (defendant's device in the First Circuit case) functions as the Court of Appeals in the Sixth Circuit and Judge Brown, of Providence, found the heels to function (R. p. 49)."

As the litigation now stands, devices which infringe in the Sixth Circuit do not infringe in the First Circuit.

The patent covers an improvement in rubber heels which revolutionized the rubber heel industry. In the words of Judge Westenhaver, the invention is one of a high rank and entitled to a broad range of equivalents. Though the patent covers a commonplace device, about half a billion heels covered by the patent have been made and sold under it in seven years. Since the patent has been held valid, an understanding of the invention and its place in the art is not necessary to decide this petition.**

The particular embodiment of the device illustrated in the patent in suit had a curved upper side edge as illustrated at A in Figure 1 hereof.

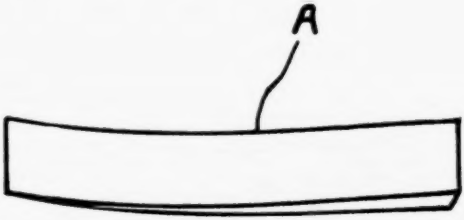

Fig. 1

The infringers sought to avoid the patent by making this edge straight, as shown at B in Figure 2 hereof.

**The invention and its importance are explained in the opinion of the Court of Appeals for the Sixth Circuit and in the opinion of Judge Westenhaver, quoted with approval by that Court, 260 Fed. 939, and in the opinion of Judge Brown, 266 Fed. 375.

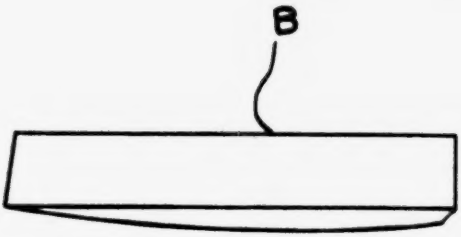

Fig. 2

The Sixth Circuit Court of Appeals held (260 Fed. 947 and 269 Fed. 270) the device of Figure 2 to infringe. The First Circuit Court of Appeals held that such a device did not infringe.

The Sixth Circuit Court of Appeals held infringement notwithstanding the straight side edge B of the heel of Figure 2; the First Circuit Court of Appeals held non-infringement solely because of the straight side edge B of the heel of Fig. 2.

This point of difference is also illustrated by counsel for The Essex Rubber Company in the following cuts taken from their brief in the Court below in the instant case:

PATENTED HEEL

Fig. 3

DEFENDANT'S HEEL

Fig. 4

The First Circuit Court of Appeals has held the patent limited to the device in the upper figure (3) and that claims 5 to 9, inclusive, of the patent were not infringed by the device of figure 4. The Sixth Circuit Court of Appeals has held the same claims of the same patent infringed by the device of figure 4.

The explanation of this simple fact is a little involved in the opinions, because at times this straight or horizontal characteristic of the upper side edge has been defined by the position of the upper surface of the heel to a plane surface and the relation of the side edges to the center of the rear edge and the two breast corners of the heel.

The Sixth Circuit Court of Appeals in defining the device which that Court twice (and Judge Westenhaver as well) held to infringe, said (260 Fed. 947 and 948):

> "In the form made by the defendant * * * the upper edge of the sides and rear is all in the same horizontal plane as these three points. (The center of the rear edge and the breast corners.) Hence it is said that the defendant does not infringe."

The First Circuit Court of Appeals said of the device held not to infringe by it:

> "In substance, defendant's contention is * * * that the sides of the defendant's heels are straight and lie in the same plane as the rear upper edge and breast corners."

The record relating to infringement was the same before each of these two Courts of Appeals. In each case it consisted of the patent in suit, the file wrapper of the original and reissue patents and evidence of identity of mode of operation and function. The claims of the patent involved were the same.

LAW: Following a long established practice, supported by a uniform current of authorities of this Court, certiorari has been granted, where there has been diversity of decrees on the scope of a patent between different Circuit Courts of Appeals. Two recent cases are in point:

The case of *Hildreth vs. Mastoras* (257 U. S. 27) was brought to this Court by certiorari where the Courts of Appeals in the Fourth and Ninth Circuits construed Claim 1 of the Dickinson patent differently.

The case of *Weber Electric Company vs. Freeman Electric Company* (256 U. S. 668) was brought to this

Court on certiorari where the Second and Third Circuit Courts of Appeals construed Claim 1 of the Weber patent differently.

The instant case is on all fours with each of these cases. A careful review of the reports discovers no reported cases where the facts are as, or even substantially as, the facts in this case where certiorari has been denied.

ARGUMENT.

I.

In view of the clear application of these cited cases to the instant case, it seems superfluous to refer to other cases where this patent has been adjudicated or other reasons for the grant of the certiorari here applied for, yet, if there is any doubt in the court's mind as to the wisdom of granting the writ, there are both other cases and other reasons which should be considered.

While the decision of the First Circuit Court of Appeals is in affirmance of the District of Massachusetts, it is in effect a reversal of Judge Brown in the District of Rhode Island (266 Fed. 375) who held to infringe claims 5 to 9, inclusive, of the patent, a device admittedly the same as the device held not to infringe the same claims by Judge Bingham in the District of Massachusetts and the First Circuit Court of Appeals.

In addition to differing from the Sixth Circuit Court of Appeals, the First Circuit Court of Appeals differs from the Seventh Circuit Court of Appeals, who, in the case of *United States Rubber Co. vs. I. T. S. Rubber Co.*, 288 Fed. 786, said that it lined itself with the Sixth Circuit Court of Appeals. After quoting the Sixth Circuit Court (page 790), the Seventh Circuit Court said:

"We agree with this statement, and believe it wholly applicable to the appellant's lift now under consideration."

At the top of page 791, the Court of Appeals for the Seventh Circuit said:

"We agree fully with the holding of the Circuit Court of Appeals for the Sixth Circuit, when it says:" (Follows quotations from the Sixth Circuit opinions.)

Further, at page 793:

"We agree with other courts in that respect. (Citation from the Sixth Circuit.) Our conclusion brings us in line with the holdings of other courts upon this patent and to the belief that the court below was led into a fallacious line of reasoning by applying an erroneous test."

In this decision, the Seventh Circuit Court of Appeals reversed Judge Luse, who had tried upon the merits a case under the Tufford patent. If, therefore, it be contended that some of the Sixth Circuit cases were decided on preliminary injunction proceedings, there is here a Seventh Circuit case tried upon the merits where the Court of Appeals in the Seventh Circuit gives the patent a different construction from the construction given in the First Circuit.

The Court of Appeals in the Seventh Circuit reversed Judge Luse (278 Fed. 975) and the Court of Appeals in the Sixth Circuit reversed Judge Westenhaver in cases later than those cited *supra* to bring such Courts of Appeals to the position which differs from the position of the Court of Appeals in the First Circuit but *not* because Judges Westenhaver and Luse agreed with the Courts in Massachusetts or with the Court of Appeals in the First Circuit, but because each Judge

Westenhaver and Judge Luse had given to the claims in question a broader and different interpretation from any of the other courts.

It results that three interpretations have been given the same claims of the Tufford patent and that the courts stand substantially as follows:

(1) The narrowest interpretation, First Circuit Court of Appeals and District Court of Massachusetts.

(2) The intermediate interpretation, the Sixth and Seventh Circuit Courts of Appeals and the District Court of Rhode Island as far as Judge Brown went.*

(3) The broad interpretation, Judge Westenhaver and Judge Luse.

There is now pending in the Third Circuit a case on the same claims of the same patent and in which the lower court has adopted, as far as can be judged, the intermediate position. This case is now on appeal and being held up awaiting the decision of this Court on this petition and will proceed in case this petition is denied.

The reported decisions on these claims are to be found at 260 Fed. 939; 260 Fed. 947; 263 Fed. 979; 266 Fed. 375; 269 Fed. 270; 270 Fed. 593; 268 Fed. 250; 278 Fed. 975; 276 Fed. 478; 281 Fed. 5; 288 Fed. 794; 288 Fed. 786. In addition there are seven unpublished opinions and a half a dozen or more cases settled or taken by default. In fact, we find in the reports no patent which has been so much litigated or one over which there has been such diversity of view among the courts adjudicating it.

---

*The device before Judge Brown did not involve the point upon which the Sixth Circuit Court of Appeals disagreed with Judge Westenhaver and the Seventh Circuit Court of Appeals disagreed with Judge Luse.

II.

Several questions of public interest are involved.

The First Circuit Court of Appeals read into one of the claims a word and with it a limitation, though the same word and the same limitation appeared in other claims in suit, whereas other courts have refused thus to reconstruct a claim. We recognize the rule that claims may be construed but we find no other case in which a word has been read into a claim to make out a case of non-infringement. It seems to us that it is a matter of public interest—and great public importance as well—to decide once and for all whether a patent, unlike all other forms of contract, may be revised and remade by the court where there is neither fraud nor mutual mistake.

No request that the patent be thus revised nor allegation of fraud or mutual mistake appeared in the pleadings; nor was evidence submitted upon that question by either party except that the file wrapper was submitted by the defendant for an avowedly sole and different purpose (R. p. 100). It seems to us that it is of both great interest and importance to the public to know if patents, unlike all other forms of contracts, may be revised and remade by the court where that issue has been neither raised by the pleadings nor opportunity been presented the patentee to submit evidence on the question.

It has been contended that certain limitations were placed upon the adjudicated claims of the Tufford reissue patent during the prosecution of the same. Some of the courts have so thought—others have not. Thus Judge Bingham said:

> "It is apparent from the matters referred to as having taken place during the course of proceed-

> ings in the Patent Office that the patentee sought broad claims, but was denied them, and acquiesced in the denial."

Judge Westenhaver said (260 Fed. 945):

> "The applicant did not modify or limit his claims as a result of these repeated rejections, and finally the Examiner, upon further consideration, admitted his error and the patent was issued."

The compromise between these contradictory pronouncements lies in the fact that the alleged limitation said to have been placed in the claims during the prosecution in the Patent Office was taken out before the reissue was granted. Such alleged limitation was eliminated after the Examiner "admitted his error" as Judge Westenhaver said. This litigation therefore presents this question which does not seem to have been decided by this Court: Where a limitation written into a claim during the prosecution thereof in the Patent Office is cancelled from the claim before the termination of those proceedings and the patent issues with the claim freed from such limitation, may the limitation be read back into the claim by the court? It seems to us that it is of great importance to the public to have an answer to this question from this Court.

After the decisions of the Sixth Circuit Court of Appeals reported in volume 260 of the Federal Reporter, plaintiff (petitioner here) instituted suits in the Sixth Circuit against certain jobbers who were infringing the patent (according to the Sixth Circuit Court of Appeals) by selling heels of the defendant (respondent here) in that Circuit. Respondent apparently fearing to contest the issue in the Sixth Circuit directed that these jobber suits be so conducted that default interlocutory decrees were entered, holding, *inter alia*, infringement by identi-

cally the same devices as were involved in the First Circuit case and held non-infringing there. In, at least, two of these cases these interlocutory decrees were superseded by final decrees, *based upon stipulations entered into by the duly appointed attorneys of the parties in the First Circuit case duly authorized and paid, to the knowledge at the time of the other party, which final decrees held, inter alia, infringement by devices identical with those held not to infringe in the instant case.* Each of the decrees (R. p. 268 and 249) entered by Judge Tuttle are as stated in the preamble to the decrees based upon "a stipulation by counsel" and the decree at page 249 is signed and approved by counsel. It is not therefore the frequent question of estoppel by a default decree, but the question of whether or not the respondent is estopped by a final consent decree based upon stipulation entered into by respondent and which decree was signed and approved by respondent. A decision by this court upon the effect of such stipulated decrees would be of great public importance. It seems to us that it is of great importance for this Court to decide this question.

The litigation on this patent has continued for seven years and the scope to be given the patent is further from being settled now than when the litigation was started. The patent covers a valuable invention, and the manufacture thereunder has been and is now remunerative, so that the litigation must and will continue until the questions now open are settled. Six District Court trials, all substantially coextensive in the issues involved, have already been held on the patent. Nine times have arguments been had on the patent in the various Courts of Appeals. As we have said, another suit on the patent on its way to the Third Circuit Court of Appeals is now stayed waiting decision on this peti-

tion. It would therefore seem that this Court would be justified in granting this petition, if only to settle and terminate the litigation.

We recognize the heavy burden imposed upon this Court but it would seem that economy of judicial time, as well as the time of the litigants, demands that this litigation and the scope of the patent be settled by a court of supreme authority.

The plaintiff, as well as other manufacturers of rubber heels, should know the scope of the claims of this patent. As the matter now stands, they do not know and a decision by this Court is necessary in order that they may know.

We want to repeat that this petition is based upon contrary decisions on the scope of the patent. The devices involved are structurally and functionally the same. This does not involve a question of devices structurally or functionally different where one might infringe and the other might not infringe.

Here, if one device infringes, the other also infringes; if one does not infringe, the other does not. It is purely a question of the scope of the same claims as applied to the same structures and the question is of the same vital importance as the question of validity or non-validity.

MELVILLE CHURCH,
CHARLES A. BROWN,
For Petitioner.

FILED
FEB 23 1926

In the Supreme Court of the United States

OCTOBER TERM 1925.

No. 229.

THE L. T. S. RUBBER COMPANY,
Petitioner,

vs.

EMPIRE RUBBER COMPANY,

BRIEF FOR THE L. T. S. RUBBER COMPANY.

[redacted]
P. O. Address:
For Petitioner.

[redacted]
Of Counsel.

In the Supreme Court of the United States

OCTOBER TERM 1925.

No. 229.

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,

BRIEF FOR THE I. T. S. RUBBER COMPANY.

MELVILLE CHURCH,
F. O. RICHEY,
For Petitioner.

RICHEY & WATTS,
Of Counsel.

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In the Supreme Court of the United States

OCTOBER TERM 1925.

No. 229.

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,

BRIEF FOR THE I. T. S. RUBBER COMPANY.

I.

STATEMENT OF THE CASE.

Status: This is a patent infringement suit brought to this Court by writ of certiorari directed to the First Circuit Court of Appeals who construed the patent in suit more narrowly than, and held non-infringing a device held to infringe by, the Sixth Circuit Court of Appeals.

The patent in suit has been litigated in many courts.[1] There have been many infringers. The litigation was started nine years ago and some is still pending.

Though Mr. Tufford, the inventor, did not create a new art, he advanced an art substantially.

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[1] 260 Fed. 939 (C. C. A. 6); 260 Fed. 947 (C. C. A. 6); 263 Fed. 979 (C. C. A. 6); 266 Fed. 375 (D. C. D. R. I.); 268 Fed. 250 (C. C. A. 6); 269 Fed. 270 (C. C. A. 6); 270 Fed. 593 (D. C. D. Mass.); 276 Fed. 478 (C. C. A. 1); 278 Fed. 975 (D. C. N. D. Ill.); 281 Fed. 5 (C. C. A. 1); 288 Fed. 786 (C. C. A. 7); 288 Fed. 794 (C. C. A. 6) and 1 Fed. (2nd) 780 (C. C. A. 1). There are in addition a number of unpublished opinions.

The patented device has been made and sold by the millions. It is most useful and its inventor has established an industry about it owned largely by him.

The prior art (Nerger patent) relied upon to limit the patent is practically paper art and concerns an invention which was tried and failed in practice when effort was made to use it. It was neither useful nor advanced the art. It was crude and did not work. It differs substantially structurally from the Tufford device.

Mr. Tufford succeeded where others had failed though many men had tried and many means had been tried to solve the problem.

Defendant's[2] devices operate like and realize the same results as the Plaintiff's devices.

Defendant concedes—

That Plaintiff has title to the patent, (R. pp. 10 and 1);

That the patent in suit is good and valid, (R. p. 10);

That Mr. Tufford was the first, true, original and sole inventor of the device of the patent in suit and that he was entitled to a patent therefor, (R. pp. 10 and 1);

That the reissue application was duly made, that Mr. Tufford complied with the Act of Congress relating to reissues and that the reissue patent in suit was "issued in due form of law," (R. pp. 10 and 2);

That defendant infringes if the Sixth Circuit Court of Appeals and Judge Brown of Providence are correct (R. pp. 33 and 34) (this would also include Judges Westenhaver and Luce); and

That the defendant's devices function as the Sixth Circuit Court of Appeals and Judge Brown found the Plaintiff's devices to function. (R. p. 34.)

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[2]We designate the parties as they were designated in the trial court.

In fact, everything is admitted except the file wrapper defense. (R. p. 34.)

The questions involved are:

(1) Infringement involving the scope of the patent as effected by the file wrapper.

(2) Estoppel by *res adjudicata.*

THE ISSUE.

On infringement:

The particular embodiment of the device illustrated in the patent in suit had a curved upper side edge as illustrated at A in Figure 1x hereof.

FIG. 1x.

Defendant seeks to avoid the patent by making this edge straight, as shown at B in Figure 2x hereof.

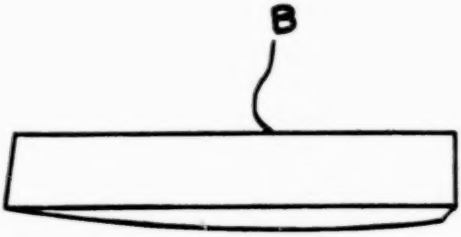

FIG 2x.

The Sixth Circuit Court of Appeals held (260 Fed. 947 and 269 Fed. 270) the device of Figure 2x to infringe. The First Circuit Court of Appeals held that such a device did not infringe.

The devices operate alike and realize the same results. They are in substance the same.

(1) Defendant asks that a limitation be read into claim 8 to make out non-infringement. Defendant from the file wrapper says the Examiner thought the claim contained the limitation. We say the claim cannot be remade by adding an element not now in the claim whether the Examiner thought it was there or not, and that it was omitted purposely;

(2) Defendant asks that the last amendment made to each claim in suit be ignored or that the claims be remade to read an element out of the claims and read back another previously cancelled out. We say that the amendment cannot be ignored and that the claims cannot be remade;

(3) Defendant asks that limitations be read into claims 7 and 9 to make out non-infringement, and we say again the claim cannot be remade; and

(4) This useful invention which advanced its art, is entitled to a liberal construction. Defendant asks for a narrow and constrained construction.

On the estoppel question we contend that the action of this Defendant in suits brought against its jobbers in the Sixth Circuit estop it from denying infringement here.

II.

The First Circuit Court of Appeals erred in holding (1) non-infringement, and (2) in holding no estoppel of Defendant by the decrees in the Sixth Circuit against the vendors of the Defendant's devices.

III.

LAW POINTS.

A.

Where the invention has advanced the art substantially, this Court will construe the patent liberally.

Eibel Process Co. vs. Minnesota & Ontario Paper Co., 261 U. S. 45; 67 L. ed. 523;

Winans vs. Denmead, 15 How. 338, 341, 14 L. ed. 720, 721;

Corning vs. Burden, 15 How. 265, 269, 14 L. ed. 689, 690;

Turrill vs. Michigan S. & N. I. R. Co., 1 Wall. 491, 510, 17 L. ed. 668, 672;

Providence Rubber Co. vs. Goodyear, 9 Wall. 788, 795, 19 L. ed. 566, 568;

McClain vs. Ortmayer, 141 U. S. 419, 425, 35 L. ed. 800, 803, 12 Sup. Ct. Rep. 76.

B.

An element not in a granted claim cannot be read into the claim to make out non-infringement.

McCarty vs. Lehigh, 160 U. S. 110;

Keystone vs. Phoenix, 95 U. S. 274;

Wollensak vs. Sargent, 151 U. S. 221;

Frederick vs. Russell, 85 Fed. 224;

Acme vs. Cary, 96 Fed. 344;

Nisbet vs. Perkins, 269 Fed. 633.

C.

A granted claim cannot be modified merely because the Examiner may have considered or thought it so modified.

Hildreth vs. Mastoras, 257 U. S. 27;
Acme vs. Cary, supra;
Nisbet vs. Perkins, supra.

D.

A patentee is not limited to the specific device illustrated and described in his patent.

United States vs. Societe, 224 U. S. 328;
Hotchkiss vs. Greenwood, 11 Howard 248;
Winans vs. Denmead, 56 U. S. 330; 15 Howard 330.

E.

Change in *form* does not avoid infringement where defendant's device operates and realizes the same results as the patented device.

Winans vs. Denmead, 15 Howard 343;
Paper Bag Machine Case, 97 U. S. 120;
Nathan vs. Howard, 143 Fed. 889 (C. C. A. 6 Lurton, J.).

F.

A claim broadened during the file wrapper proceedings cannot be narrowed by reading out the broadening matter.

Morgan Envelope Case, 152 U. S. 425.

G.

To omit an element and secure an important advantage is high order of invention.

Lawther vs. Hamilton, 124 U. S. 1;
Morey vs. Lockwood, 8 Wallace 230;
Dunn Mfg. vs. Standard, 163 Fed. 521, C. C. A. 6 Judge (later Justice) Lurton.

IV.

FACTS[3] ON UTILITY AND ADVANCE IN THE ART.

Introductory[4]—John George Tufford had been an ordinary shoe cobbler for about thirty-five years when he invented the rubber heel covered by the patent here involved. Being without the means essential to patenting and marketing his device, he sought outside aid and met with refusal and discouragement. Persisting he secured the assistance of two retail shoe clerks in a shoe store in Elyria, Ohio. After the patent was secured, these three men hired a bookkeeper, raised about twenty-three thousand dollars here and there among their friends and embarked in the rubber heel business in competition with Goodyear Tire & Rubber Company, The O'Sullivan Rubber Company, United States Rubber Company and others who had placarded the country with advertisements and who canvassed the country with salesmen. The business thus launched in 1916 has since been conducted by these four men. The patented devices sold rapidly and widely and on their merits for there was little advertising and no canvassing worth mentioning. Judge Westenhaver in the summer of 1918 appraised the situation as follows, (260 Fed. 943):

> "The sales of the Tufford lift in February, 1915, were 6,696 pairs, and for the entire year 748,189 pairs. The sales of the year 1916 were 4,529,518 pairs; for 1917 they were 12,733,567 pairs; and for the first six months of the year 1918, 13,893,245 pairs. For the month of June alone, 1918, the number sold were 2,279,045 pairs. Complainant has put in capital from first to last of less than $30,000. Its undivided profits

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[3]Affirmance of the facts stated in this introduction is found at various places in the record (pp. 35, 169-170, 185) and reiterated in the opinions of the Courts, 260 Fed. 941-946.

[4]Notwithstanding the admission of the validity of the Tufford claims in suit, the facts and discussions of this section are pertinent in view of the recent holding of this court in Eibel vs. Minnesota, 261 U. S. 45.

January 1, 1918, were $800,000. Its net earnings alone for the year 1917 were $482,000. The Miller Rubber Company began with 10 or 15 persons in its press room in February, 1915, making these heel lifts; it now has 160 employes so engaged. Its investment for this purpose totals a half million dollars. It was making at the time of trial 75,000 pairs a day, and trying to reach an output of 120,000 pairs a day. Mr. Griffith says the company has never been able to keep up with the public demand for this heel lift."

These achievements continued, except as affected by infringements, as is indicated in various parts of the record, and during the progress of the litigation as reported in the decisions.

This astonishing commercial success is understandable in view of the precarious condition of the rubber heel business when Mr. Tufford made his invention. Softness to the tread and quietness in walking, the salient advantages of rubber heels, were neutralized by the faults and ills of the rubber heels in use commercially prior to Mr. Tufford's invention. These ills incurred the hostility of the cobbler as well as of the user, and both stood bars to the progress of the rubber heel. Nation-wide advertising and canvassing had failed to convert the cobbler and the user to the rubber heel involving as it did the faults which we will proceed to describe. Literally, every rubber heel was sold at the bayonet point of the advertiser. (R. p. 41, 170, 184, 260 Fed. 941).

We will here digress to explain the terms of the rubber heel. The rubber heel as known in this record, is substituted for certain layers of leather called lifts by the cobbler who looks at the heel from the bottom, and therefore calls the heel pieces "lifts" instead of under pieces. The heels here involved are in reality rubber lifts, but are commonly called rubber heels, and we will therefore call

them "heels." The first rubber heels were made flat just like the leather lifts and were substituted for one or more of the leather lifts. We have illustrated such a flat rubber heel in Fig. 1.

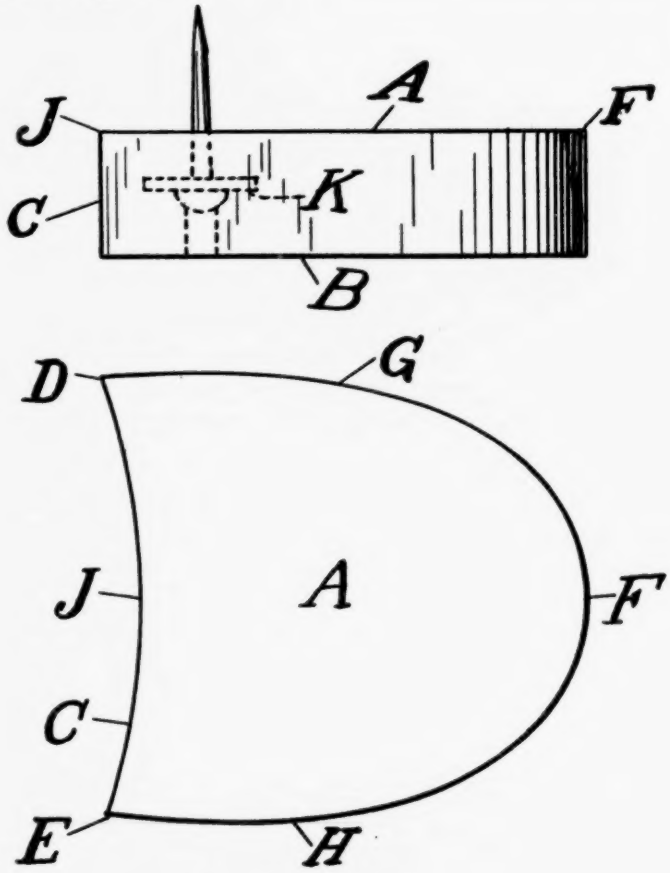

Fig. 1

The attaching face of the heel is shown at "A." This face comes next to the bottom of the leather part of the

heel when the rubber heel is attached. The other face "B" is known as the tread face. The front of the heel "C" is called the breast. The breast is usually curved inwardly as indicated in Fig. 1. The corners "D" and "E" are known as the breast corners. The back part "F" is called the rear edge. The edges "G" and "H" are known as the side edges and the edge "J" is known as the breast edge. The heel is pierced at various places part way through for the passage of the nails or screws by which the rubber heel is attached. Molded in the heel midway between its faces are small metal plates or the like upon which the head of the nail rests when it is fully seated. Most frequently these small plates are circular and, being pierced for the nails, have the shape of a washer and hence are commonly called washers. These plates perform no other function than that of preventing the head of the nail from tearing through the soft rubber.

These prior flat heels realized the rubber heel's salient advantages of softness to the tread and of quietness in walking. When, however, the cobbler drove home the attaching nails or screws, the rubber under the plates would be compressed by the pressure of the attaching means and cause the rubber heel to spring away from the leather about the edges as shown in Figs. 2 and 2A.

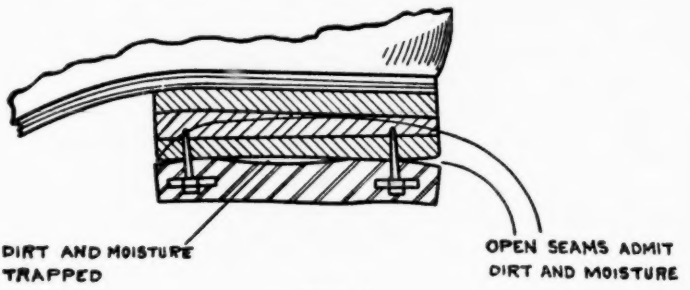

FIG. 2.

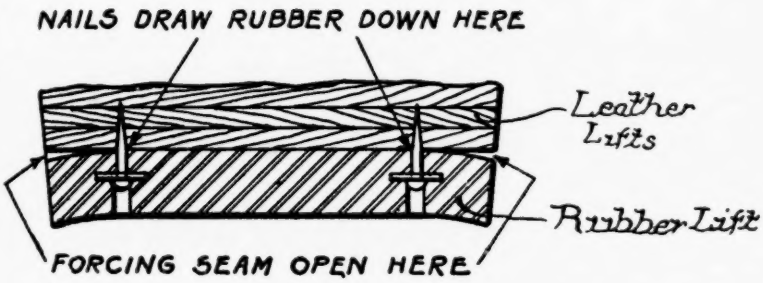

FIG. 2a.

This made the job unsightly and water, filth and the like crept, or was drawn, into the open seam and fouled the heel. This filth was frequently expelled in the house or at other inopportune times.

This fault of the flat rubber heel militated against its success and stood a bar to its general introduction. In an effort to remedy this fault, the cobbler would cement the rubber heel to the leather in addition to nailing it on. Too much time and labor were consumed in the cementing operation. The contiguous surfaces of heel and leather had to be cleaned and smoothed with rasp and sand paper before the cement could be applied. After the cement was applied the shoe and the heel had to be set aside for awhile that the cement might partly dry to the desired consistency or stickiness. While the cement was drying it had to be watched that it did not overdry. When well and completely done the cementing was a mere makeshift for no satisfactory cement for cementing rubber to leather is known. Sooner or later the heel was caught and the cement ripped loose. This was often caused by pulling off rubber shoes, or striking the heel inadvertently against some object such as the edge of a step or in the trimming of the rubber heel after attachment. The manufacturer

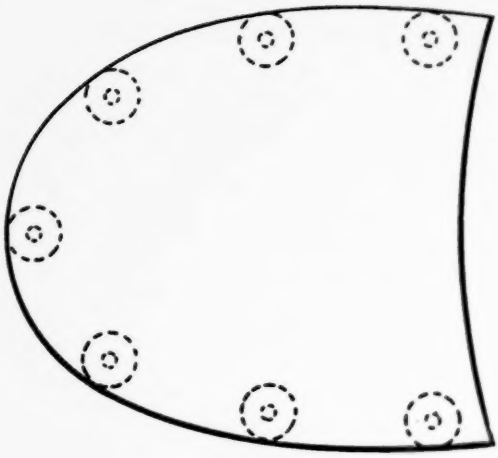

Fig. 3

of the heels sought to remedy this defect by moving the nails and washers closer to the edge of the heel, as shown in Fig. 3. By so doing it was hoped that the edges of the heels could be nailed together and the opening of the seam prevented, but this change introduced other and additional ills. The trimming area of the heel was so limited that the cobbler frequently trimmed with his knife into the washer, injuring his knife and leaving the washer exposed at the outside. The wearing area was also limited and very shortly the washer was exposed, as indicated in Fig. 4, with the result that the washer, and very soon the nails, scraped on the floor and pavement. It also frequently happened that the nail intended to attach a rubber heel would strike a nail in the leather heel and be deflected through the leather and exposed, mutilating the leather heel and, in the case of wooden heels, sometimes chipping off a portion of the heel. This is indicated in Fig. 5.

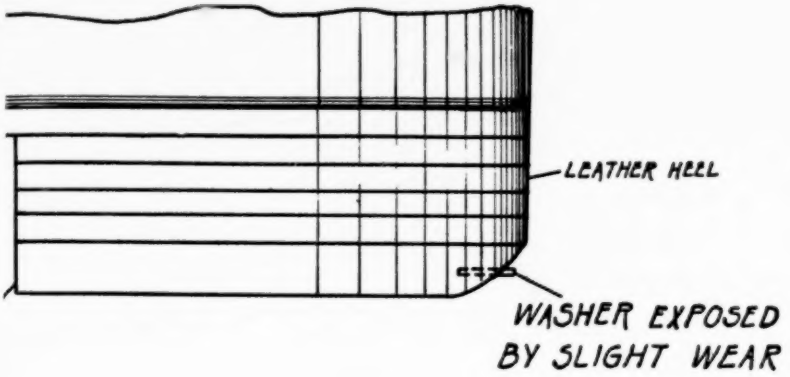

FIG. 4.

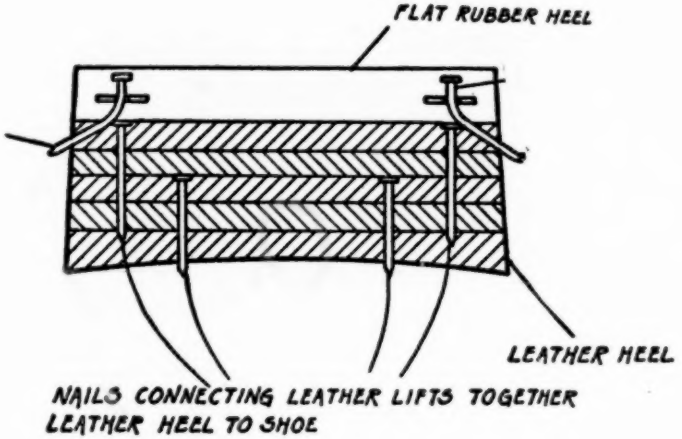

FIG. 5.

Flat rubber heels were utterly impracticable for women's French wooden heels with the well-known flared bottoms. If the nails were near the edges, the wooden heel was chipped and destroyed. If the nails were set in

far enough to avoid this consequence, the seam was wide open.

Many efforts were made prior to Mr. Tufford's to remedy these evils of the rubber heel. We will not undertake to discuss all of these efforts, but will content ourselves with the more important ones.

It was proposed to attach the rubber heel to a leather lift at the factory and nail leather to leather in the cobbler's shop. This only postponed the evil day for a little while. (R. p. 406.)

Heels were made with a raised margin about the edge of the attaching face such as shown at A, in Fig. 6. (R. p.

Fig. 6

422.) It was planned to pinch this margin by the pressure of the nails between the rubber and the leather and thus dam the seam between the rubber and leather surfaces. This plan, however, was open to the objection that the heel could not be trimmed without trimming away the dam more or less and in some places entirely, thus leaving a wider and more objectionable opening. The trimming area which was limited to the width of the margin was too narrow. Some of these heels were equipped with large metal plates in an effort to better pinch the dam between the leather and rubber surfaces. These heels met with some success especially when attached to the shoes by the manufacturer of shoes who, knowing in advance the size

of the shoe heel, could mold the rubber heel to size, but these heels were no more satisfactory to the cobbler than the flat heels.

Large metal plates of various forms and shapes (R. p. 422 and 414) were employed, or their use suggested, in various forms of rubber heels. It was hoped that these plates would prevent the opening of the seam as illustrated in Figs. 2 and 2A hereof. This was promising from a theoretical standpoint and many efforts were made to solve the problem by the use of heels made of rubber and iron or steel plates. A few of these contraptions were manufactured and considerable effort was expended in futile attempts to make them successful commercially. Although the records in the various cases, as well as the opinions of the Courts, are replete with discussions of these heels and the reasons for their failure, we will limit our reference here to only one of these heels and discuss that one briefly.

The Nerger heel has received, in this litigation, a prominence which it did not deserve because on paper it appears to be a solution of the problem and to embody some of the Tufford features. When divorced from the paper showing, and applied in practice, it was a flatter failure than any of the other efforts to solve the problem. Mr. Nerger conducted a number of campaigns very similar to the sampaign that Mr. Tufford conducted in behalf of his heel. Each of Mr. Nerger's attempts were failures. Mr. Tufford's single attempt was successful. (260 Fed. 944.)

The principal trouble with these Nerger heels was that the iron or steel plates destroyed the salient features of the rubber heel. The plates about which the rubber was molded made the device about as hard as a leather heel and stiffer than the leather lifts for which it was substituted. (R. p. 103.) These heels should, and in fact

were, called plate heels. They should not be classified with rubber heels at all. The composite structure was not entitled to be called a rubber heel any more than a suit of armour is entitled to be called a suit of clothes. The hard, stiff, metal plate dominated the soft and resilient rubber so that the characteristics of this composite device was that of the iron or steel rather than that of the rubber. They were more iron than rubber heels. In addition to sacrificing the salient features of the all rubber heel, these plate heels limited the trimming area because the edges of the plate had to be extended to near the margin, if the seam was to be sealed, the same as the nails and small plates had to be, as shown in Fig. 3. The plate bridged the irregularities in the leather, leaving them open. Unless the plate was made of hard steel, the heel was liable to be bent in attaching or in use or caught in some such way as indicated in Fig. 7, and the plate bent back.

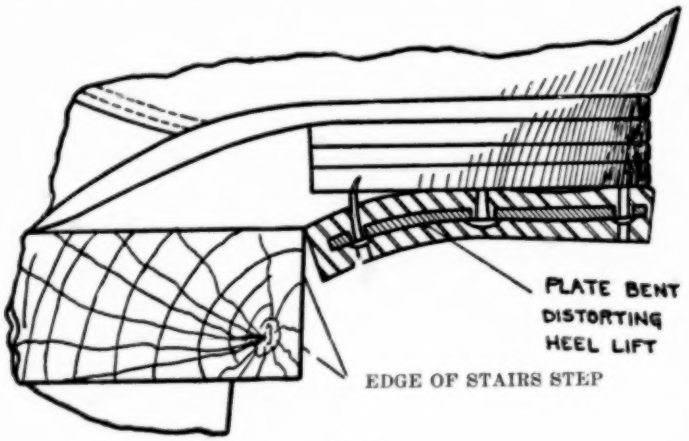

FIG. 7.

The seam thus opened could never be closed again unless the heel was taken off and the kink taken out of

the plate. If the plates were made of hard steel they were liable to be cracked in the manufacture, attaching or use of the heel. These plate heels were very difficult to manufacture as compared with the other heels because the rubber had to be molded on both sides of the plate.

Various forms and shapes were given to these plates. Nerger made his structure scoop-shaped; others made them flat and others employed them with the raised margin (Yahraus 817355). Some employed two or more of these expedients together (*ibid*). The failure of the Nerger heel is typical of the failure of all these plate heels and we will limit our discussion of that matter to a quotation from the opinion of Judge Westenhaver quoted with approval by the Court of Appeals in the Sixth Circuit and which appears in 260 Fed 945:

> "I have examined the testimony in deposition form showing previous sale and use of the Nerger heel. Nerger ordered from Morgan & Wright, rubber manufacturers of Chicago, during the years 1901 and 1902, some 600 pairs of heels. These were peddled by him or one or another of his sons to shoe cobblers in and about Chicago. Nerger, his sons and one or two other witnesses also testify that these heels gave satisfaction, adhered closely at the edges, did not gap away from the leather, and did not spread beyond the leather, and wore well. Giving full weight to these statements, but taking his testimony as a whole, I am convinced that the Nerger heel lift was neither successful nor practicable, that a limited number only were sold, and that, owing to the inherent defects therein, it failed to meet or solve the problem of a desirable heel lift. Nerger brought this heel lift to the attention of different persons in his efforts to enlist their co-operation in making and selling them, but always without success. His invention must be regarded as a practical failure."

(We will say more about the Nerger heel later herein.)

Various modifications of the Nerger and other plate heels, both as illustrated in patents and in heels themselves, were urged upon the various Courts by various Defendants in the litigation over the Tufford patent and resulted in some of the judicial view limiting the Tufford patent. Other Courts refused to accept these heels other than as they were illustrated or described in the patents or found to have been tried in practice.

The outstanding fact in the history of the iron plate heel was that it was thoroughly tried in practice in various forms and by various parties independently of each other and had failed so completely that when Mr. Tufford came into the field, the plate heel was obsoleted and would probably never have been resurrected for any purpose had not this litigation been instituted

We have perhaps devoted too much space to the prior plate heel in view of the formal admission in defendant's answer of the validity of the Tufford patent.

Outstanding also is the fact that when Mr. Tufford made his invention the trade had accepted the flat heel, with all its faults, as the best of these make-shifts. It then seemed that the rubber heel industry must survive or perish with the flat heel.

We have thus briefly reviewed the more important prior art and stated the situation that the Court may comprehend the picture and understand the importance of the invention and the scope to which the Tufford patent is entitled. In an ordinary case such a review might be unimportant or unnecessary since the *validity of the patent is here conceded.*

Mr. Tufford's Invention: The reasons for the failures of prior efforts we have recounted are clear when it is

understood that the problem involved apparently irreconcilable antagonisms.

A tight seal of a seam between the soft rubber heel and the hard leather heel must be made by attaching means applied remote from the seam. A firm connection must be made without stiffening the rubber heel with plates or the like. The connection must hold and the seam remain sealed for the life of the heel. The seam must be tightened and sealed at the edges by attaching means applied well away from and inside the edge.

In his solution, which is patented and here involved, Mr. Tufford employed an all rubber heel, discarded all plates, raised margins and other appendages, moved his attaching means inside further than any had ever done before, and cupped his heel. Then, when the nails were driven in, the heel was flattened and its edges pressed and held tightly against the leather shoe heel edge by the retractive effort of the rubber operating as the heel tried to return to its cupped form. We have illustrated this action in Fig. 8 below, where a Tufford heel is shown in section as it is nailed down. The sealing increases as the heel is depressed and is finally permanently tight when the nails are set. There was no longer need of sand papering and cementing. The old lifts were torn away and the rubber heel nailed right on. What had taken half an hour could be done in a few minutes.

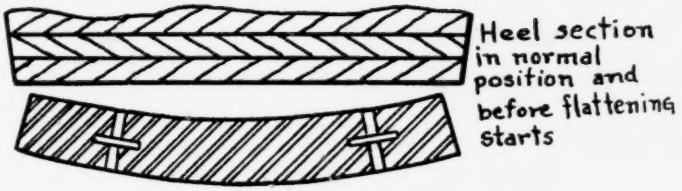

Fig 8 A

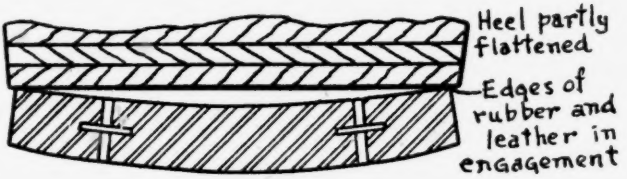

Fig 8 B

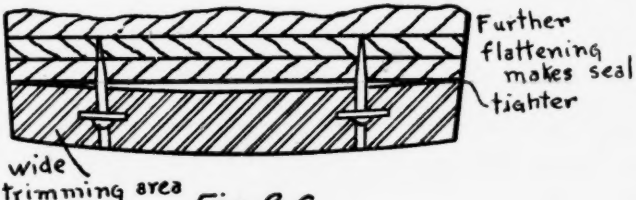

Fig 8 C

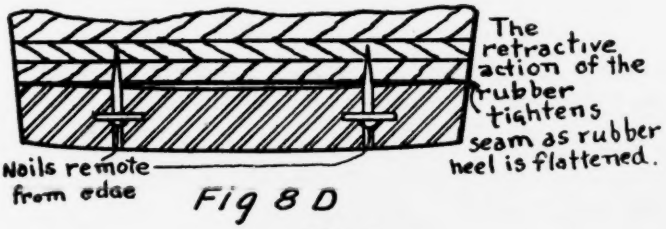

Fig 8 D

FIG. 8.

The trimming and wearing areas were increased. All the faults of the old heels were gone and all their advantages preserved (R. pp. 38, 39).

The cobbler who had been the enemy of the rubber heel was now its friend and ardent promoter. It had been harder for him to attach a rubber heel than a leather heel; now it was easier. Those who liked the softness and quietness of rubber heels, but who would not tolerate the open seam, could now have rubber heels with seams as tight and sightly as the leather heels. Mr. Tufford and his shoe clerks and his bookkeeper became captains of industry over night. From then until now the use of the rubber heel spread until now, as is well known, its use is almost universal. Almost immediately a multitude of infringers sprung up anxious to share with Tufford the fruits of his invention; some of these infringers have been suppressed in the extensive litigation over the Tufford patent, and some of them still practice. In fact about everything happened that usually happens when a revolutionary invention is made in any industry. The humble shoe heel industry does not differ from others in that respect.

Against this record of achievement the defendants oppose a Babel of verbal technicalities. No one now challenges either the importance of Mr. Tufford's invention or its complete remedy of all the maladies of the rubber heel. No one now asserts that his invention is anticipated. No infringer denies that his heels embody the mode of operation and result of the Tufford invention. So thoroughly have all these contentions been established by Mr. Tufford that we find the defendant in the case at bar admitting the validity of the patent, admitting infringement under the decision of the Sixth Circuit, agreeing that there is infringement under the decision of Judge Brown which was based on equivalency and we find defend-

ant here presenting the sole defense of alleged limitations of the patent by the file wrapper.

V.

Infringement:

Defendant's counsel thus stated his position (R. p. 33):

> "The question of infringement directly is not in issue. The answer simply cites the file wrapper as the sole defense which the Defendant puts in. * * * There is no issue as to anything except what is specifically a file wrapper defense."

(R. p. 33):

> "We deny infringement, but we do not deny infringement by those exhibits if the court follows the decision in the Sixth Circuit and Judge Brown's decision in Providence. We agree that the heels vary as Exhibits 1 and 2 are infringements under this decision. We put in the file wrapper to contest the correctness of this decision."

(R. p. 34):

> "If not, why then the Court, if it follows the decision in the Sixth Circuit and Judge Brown, will hold these heels as infringements. * * *
>
> "We admit that it (Defendant's heels here involved) functions as the Court of Appeals in the Sixth Circuit and as Judge Brown in Providence found the heels to function."

The particular embodiment of the Tufford heel illustrated and described in his patent happened to have a curved side edge (R. p. 222) as illustrated below by the reference A, added by us, to Fig. 2 of his patent which is reproduced below and made Fig. 9 of this brief.[5]

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[5] This has also been called the three-point contact heel because since the breast and side edges are curved it would engage at the breast corners and the rear edge when held against the shoe heel as in Fig. 9.

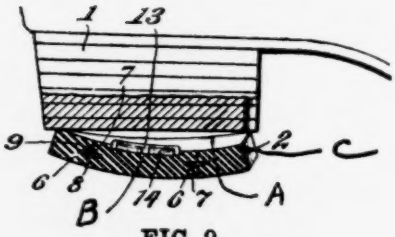

FIG. 9.

Although, whether the side edges are curved or straight has no effect upon the function, mode of operation or results of the heel, (R. p. 43) this minor detail has been the storm center of this litigation. The District Court in Massachusetts and the First Circuit Court of Appeals held non-infringement because Defendant's heels had straight side edges as illustrated in the Sanders patent (R. p. 322) showing one form Defendant's heels. (Exhibit I, series A). Fig. 5 o his patent is reproduced below (as Fig. 10 hereof) with the addition of the reference A to indicate its straight side edge.

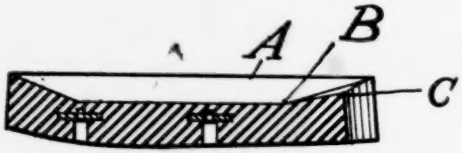

Fig. 10

This question was squarely before the Sixth Circuit Court of Appeals in a number of cases and before Judges Brown and Westenhaver, and all those Courts held infringement regardless of this difference.

The particular embodiment of the Tufford heel illustrated in his patent also had, when the heel was held with

its rear edge and breast corners in a horizontal plane, as is the case in Fig. 2 of his patent (R. p. 222) reproduced in Fig. 9 hereof, a spot such as B to the rear of and lower than the breast C.[6] The presence or absence of this low spot does not affect the function, mode of operation or result—except perhaps in degree—of the heels charged to infringe in this litigation. Whether the defendant's heels had a low spot back of the breast or not has also been one of the points of controversy in this litigation.

Defendant's Exhibit 1, series A heels like those shown in Fig. 5 of the Sanders patent (Fig 10 hereof) undoubtedly have such a low spot at B even more marked than the Tufford heel. One of Defendant's heels, Exhibit 2, Series B, also has the low spot back of the breast though the low spot is only slightly below the breast. These heels clearly infringe under the decisions of the Sixth Circuit Court of Appeals and it is so conceded. Indeed, the decision of that Court in the *Hill* case (269 F. R. 270) specifically held infringement where there was slight difference in elevation between the "low spot" and the breast edge.

There was some controversy and evidence both ways at the trial (R. pp. 49 and 50) concerning the slant of the other heel of Exhibit 2. This question is succinctly stated and illustrated thus:

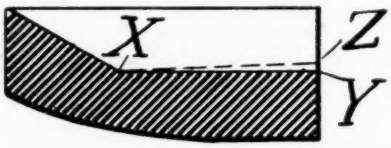

Fig. 11

[6]These heels have also been called "open breasted" heels though that expression is somewhat misleading. It should be considered not literally but with the above definition in mind.

If the center line of the second heel of Exhibit 2 in this case rises from X to Z in Fig. 11 infringement is conceded if the Courts in the Sixth Circuit and Judge Brown were right; if, however, the line runs parallel to the side edge like X Y, it is contended that there would be no infringement even under the decisions of the Sixth Circuit Court of Appeals.

In the Court of Appeals below Defendant's counsel contended that both heels of Exhibit 2 were lower back of the breast (open breasted) and therefore did not infringe under the Sixth Circuit decision though in the trial Court he had admitted the contrary. (R. pp. 33, 34.)

Defendant's counsel produced during the trial a specially prepared heel marked "Defendant's Exhibit F." In this particular heel the parts are so proportioned that the composition of rubber used is not capable of closing the breast which is remote from the curved part. Its infringement is not in issue and we do not, therefore, discuss it in detail here. It was made after this suit was started. It behaved very differently from any other Defendant's heel in this case.

After the offer of this heel, Plaintiff went out in the streets and purchased a plurality of Defendant's heels[7] and proved that they would perform the Tufford functions. (Exhibits 100 to 103, R. pp. 103-106.) Some of these Defendant's heels are "open breasted" heels and present the issue between the Sixth Circuit Court of Appeals and Judges Westenhaver, Brown and Luce.

Succinctly stated, we contend:

(1) That defendant's exhibits 1 and 2 infringe because (a) they adopt the essentials of construction

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[7]These heels bear Defendant's name, address, trade-mark, patent dates and other insignia and were found to otherwise respond to Defendant's advertisements (R. p. 165) and stipulated heels, and are undoubtedly Defendant's heels. They are not otherwise proven as such, but we do not believe Defendant can or will deny that they are Defendant's heels.

and the mode of operation and realize the results of the patented heel and (b) because they fall within the decisions of the Sixth Circuit Court of Appeals and of the three District Judges as is conceded.

(2) That the heel of exhibit 2 which is slightly lowest at the breast infringes for reason (a) and under the decisions of the three District Judges.

VI.

Litigation: We find neither in the annals of this or of any foreign country a patent over which there has been so much litigation as over the patent in suit. It is, therefore, fair to say that it is the most litigated patent of all time. Six times has the patent been tried out in open court. Nine times has it been argued in the Courts of Appeals. Preliminary injunctions and other interlocutory proceedings have been legion. Other litigation involved is now pending in the Third Circuit, awaiting this Court's ruling in this case. It seems to us that this Court, who have the authority, should make an all-comprehensive interpretation of the patent that will settle that sole remaining question forever.

VII.

THE FILE WRAPPER DEFENSE: We speak in all seriousness when we say the defense in this litigation has degenerated to the file wrapper defense, and is a mere babel of technicalities. There has been the greatest disagreement both among counsel for Defendants and the Courts regarding what, if any, estoppel has been created by the Tufford file wrapper. The holdings of the Courts on this question have ranged all the way from no estoppel at all to estoppels which emasculate the patent and deprive it of all value. Where they are not in accord they

are inconsistent, one Court finding a limitation at one point and another court a limitation at another point.

Judge Westenhaver, who tried this case twice on the merits and heard it four times on preliminary injunction proceedings besides, Judge Brown of Providence, who listened to the evidence for nearly a week and Judge Luce in the Eastern District of Illinois, who heard evidence for over a week, all found that the file wrapper placed no estoppel upon the inventor. (8)

At the other end of the range, it was first held, in the District of Massachusetts, that the patent itself limited Mr. Tufford to a heel with curved side edges, a situation we will explain hereinafter and one which if adhered to, renders the patent impotent.

The Court of Appeals for the First Circuit disagreed with such holding (281 Fed. 5).

It was then held in the District of Massachusetts that, though basis for such limitation was not in the patent, it was found in the reissue file wrapper.

The First Circuit Court of Appeals held that basis for this limitation was to be found in the file wrapper of the original patent and limited the patent to the extent of impotency.

The Sixth Circuit Court of Appeals, held that there was basis for such a holding in neither the patent, the re-

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(8) Judge Westenhaver's views are stated at 260 Fed. 945:

"The presumption of patentable invention flowing from the allowance of the application and the granting of a patent by the Patent Office authorities is strengthened to an unusual degree by the actual proceedings in this case. During the pendency of the reissue application Ferguson and Nerger were both cited against it. The examiner repeatedly rejected the application, first because of Ferguson and Nerger patents, and later on Nerger's alone, and it was not until after he had seen, inspected, and demonstrated the Nerger and Tufford heels that he passed the application. *The applicant did not modify or limit his claims as a result of these repeated rejections and finally the examiner, upon further consideration, admitted his error and the patent was issued.* In these circumstances, the granting of the patent carries more than the usual weight."

issue nor the original file wrappers, but that another and different limitation had been accepted and must by estoppel remain in the claims.

The now unsettled file wrapper questions resolve into the single question of claim remaking.

Defendant asks the Court to remake claims in three particulars, as follows:

(1) To read "rear" into claim 8, to add an element not in the claim that non-infringement may be found.

(2) To read "passing through" out of claims 5, 6, 7, 8 and 9 and read "tangent to" into each claim.

(3) To read "on every line of cross section" twice into claim 9 and once into claim 7.

We recognize the rule that the language of a claim can be construed, but that is not the proposition here. The Court is asked to remake the claim in violation of the rule in *McCarty vs. Lehigh,* and other cases cited *supra.*

(1) In each of claims 5 to 7 and 9 inclusive there appears the limitation (R. p 164):

> "the concave (or the upper concave or the concave attaching) face lying entirely below a plane passing through the *rear* upper edge and the breast corners of the lift."

The word "rear" is omitted from this expression in claim 8, which claim reads as follows:

> "8—A heel lift of resilient material comprising a body portion of uniform thickness throughout its entire area and of concavo-convex form on every line of cross section, the concave upper face of the lift lying entirely below a plane passing through *the upper edge* and the breast corners of said lift."

That infringement must be held unless the claim is thus amended or redrawn is manifest, for as claim 8 was

originally presented, allowed and now appears in the patent, it is infringed by a device whose upper edge is in the reference plane whether that upper edge be the part of the edge to the rear alone, as in the Tufford heel, (Fig. 9) or

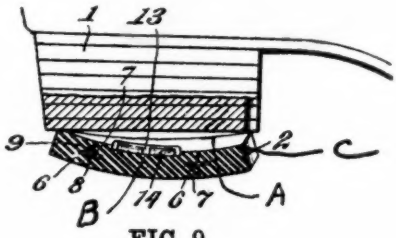

FIG. 9.

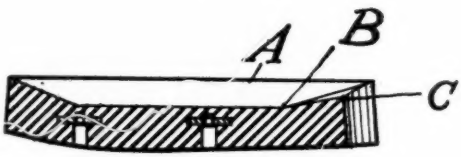

Fig. 10

the entire upper edge, except the breast edge, as in Defendant's heel, (Fig. 10). The first Circuit Court of Appeals proceeded to read this limitation into claim 8 to make it the same as in the other claims saying that the Court thought the Examiner intended that the word should be in the claim, although it wasn't in fact there.

In the recent case of *Hildreth vs. Mastoras,* (257 U. S. 27; 66 L. Ed. 112) this Court settled the law on this question by holding that what a Patent Office Examiner might have considered of the scope of a claim did not deprive this Court of the right to determine the true import of the language used in the granted claim.

In *Nisbet vs. Perkins*, 269 Fed. 633, that very point was before Judge Hand; there the defendant urged the revision of a claim to make out a case of non-infringement, and Judge Hand agreed that the examiner thought the claim contained the limitation though he thought otherwise. The learned Judge said (p. 634):

> "Hence, through his mistake the examiner did not impose a close enough limitation to narrow the patent as he meant to do. However that may be, he did what he did; and there cannot be the slightest question to my mind that, viewed as a grant, it covered all cases in which the shield was narrow. *I cannot make over the patent against the patentee, because of the mistake of the examiner in failing to phrase it properly.* The language is clear. If the defendant objects, let him widen his shield."

In *Acme vs. Cary*, 96 Fed. 344, the same Court said in rejecting the same kind of contention (pp. 345 and 346):

> "A mere remark of the examiner, 'It is not seen that there is any material difference in the claims,' does not estop the patentee from claiming the construction shown by the specification and original claim. It is the construction of the patent as finally issued which is to be considered. *Reece Buttonhole Mach. Co. vs. Globe Buttonhole Mach. Co.*, 10 C. C. A. 194, 61 Fed. 958."

This Court has always held that a claim cannot be altered by the Court either by reading or implying an element into it, and the reading of the curved side edge or three point contact limitation into claim 8 of the Tufford patent would be contrary to a long line of authority in this Court.

In *McCarty vs. Lehigh Valley*, 160 U. S. 110, this Court held, to quote the syllabus (40 L. Ed. 358)—

> "An element not mentioned in a claim for a patent cannot be read into the claim for the purpose of making out a case of novelty or infringement."

In *Keystone Bridge vs. Phoenix*, 95 U. S. 274, it was held, to quote the syllabus—

> "When a claim is so explicit, the Courts cannot alter or enlarge it";

In *Frederick vs. Russell*, 85 Fed. 224, Chief Justice (then Judge) Taft, speaking for the Court of Appeals in the Sixth Circuit said—

> "To imply as elements of a claim parts not named therein for the purpose of limiting its scope, so that it may be accorded novelty is contrary to a well settled rule of patent law."

All of this authority is consonant with the rule that contracts cannot be revised except in clear cases of fraud or mutual mistake and consistent with the well known nose of wax rule laid down by this Court in *White vs. Dunbar* (*) (119 U. S. 47).

The Court (C. C. A. 1st) undertakes to justify this action on the grounds that in that court's opinion the claim must be so revised to save it. Our answer is two-fold,—

First, the claim cannot be revised and a limitation inserted to save it any more than to make out non-infringe-

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(*) As a matter of fact, the word "rear" was omitted from claim 8 intentionally and at the direction of Mr. Tufford, but we had no opportunity to so prove because no such issue was raised either by the pleadings or the evidence, and when urged at the final hearing for the first time, surprised us completely. Since a patent is a contract, we doubt if this Court would sanction its revision without due pleadings and evidence. The file wrapper presents no evidence on the question. The adding of claim 8 without the word "rear" to the other claims in suit which contained the word "rear" proves the intention to omit the word which, as we say, is the fact. The contention that the Examiner thought the claim was so limited is based entirely upon the statement by the Examiner that claims 5, 6, 7, 8 and 9 specified language (R. p. 257) which was afterwards changed and which now appears in none of the claims. Indeed, the precise language quoted by the Examiner did not at that time appear in any of the claims. It would be just as reasonable to assume that the Examiner inadvertently included claim 8 in this group as it would be to assume that the Examiner thought the word "rear" was in the then claim 8. Indeed, if there was any error, that was the error. The whole proposition is based on speculation and surmise. The absence of the word "rear" in claim 8 could not have escaped the careful scrutiny always given claims before the patent is finally issued.

(Continued on next page)

ment, (*McCarty vs. Lehigh, supra*) and that if it is invalid without the curved side edge limitation it is invalid, but that is a question with which neither this Court is, nor that Court was, concerned because Defendant has admitted the validity of the claim and that admission applies as the claim is and not after attempted remaking. No such condition was tied to defendant's admission and plaintiff made out its case accordingly.

Second, the fate from which the Court (C. C. A. 1) fancied that the reading of the curved side edge into the claim would rescue it, is found in the Court's statement that without such a limitation the claim would be invalid "because not for the same invention as described in the original specification and drawings."

The Court then cited *Parker vs. Yale Clock Co.*, 123 U. S. 87 and quoted therefrom this Court's statement regarding the well-known rule that a patentee cannot make material additions to his re-issue patent. The facts in the *Parker* case and this Court's reasons for deciding adversely to the re-issue there are found in the following further statements by the Court—

In the court below, defendant contended that if the omission of the word "rear" had been intentional, the words "breast corners" would also have been omitted because "breast corners" are part of the edge. This resolves itself into a super-technical argument as to whether or not a corner is part of an edge. The answer to this general proposition is immaterial in view of the fact that the patentee has elsewhere defined the corner as not a part of the edge. In claim 10 and elsewhere in the specification, where the patentee's spherical embodiment is specifically described, occurs the expression "the rear upper edge and breast corners of the concave attaching face of the lift being disposed in a plane above the upper side and breast edges." Here the breast corners are said to be above the side edges and breast edges. The corners could not be above the edges, if the corners were considered a part of the edges. To hold the corners a part of the edges, we must accept the anomalous conclusion that the corners are in the edges and above them at the same time, a clear contradiction of the language used and a physical impossibility. If it is true, as the learned judge sitting in the District Court thought, that there would have been no need of reciting the "corners" in the claim, the necessity for thus reciting the corners becomes apparent when we learn that the writer of the claims considered and defined the corners separately from the edges.

"If by 'new matter' in Sec. 4916 of the Revised Statutes, *is meant such new substantive matter as might be the subject of another application for a patent,* there was new substantive matter introduced into the specification of the re-issue in the present case; for the description set forth in that specification as the foundation for the first eight claims in it, and *those eight claims themselves, might have been the subject of another application for a patent* at the time the original patent was applied for and taken out, leaving that patent valid and operative in respect to the claims it covered." (31 L. Ed. 106).

This was further explained by this Court in the following language quoted from *Coon vs. Wilson* in the *Parker* decision—

"The description had to be changed in the re-issue to warrant the new claims in the re-issue. The description in the re-issue is not a more clear and satisfactory statement of what is described in the original patent, but *it is a description of a different thing* so ingeniously worded as to cover collars with continuous long bands, and which have no short or sectional bands."

There was a gross case of intervening rights in the *Parker* case and none in the case at bar. Mr. Tufford was prompt to apply for his reissue. In the *Parker* case the Court said—

"In the present case, the infringing clock was made by the Defendant Lane more than six months before the re-issue in suit was applied for."

The law applicable to re-issues was stated by Mr. Justice Bradley in *Miller vs. Brass,* 104 U. S. 350; 26 L. Ed. 783 as follows:—

"If a patentee who has no corrections to suggest in his specification except to make his claim broader and more comprehensive, uses due diligence in return-

ing to the Patent Office, and says, 'I omitted this,' or 'my solicitor did not understand that,' his application may be entertained, and, on a proper showing correction may be made."

The whole re-issue question was squarely before the Sixth Circuit Court of Appeals who held in quoting Judge Westenhaver with approval—(260 Fed. 946)—

> "Defendant's contention that the reissue patent is for a new invention, not embodied in the original patent, is not sound.
>
> * * * * *
>
> The changes made in Figure 2 of the drawings of the reissue patent are slight and immaterial, and scarcely perceptible to the untrained eye. The additions made to the specifications are from lines 83 to 105, inclusive, on the second page. An examination of these added lines and a comparison thereof with the original does not show the introduction of any new idea not disclosed in substance in the original. These lines were added only to bring the same out with greater clearness."

The same conclusion must follow from the first decision of the First Circuit Court of Appeals. That Court said (281 Fed. 9)—

> "The specification also discloses a preferred form of heel, concavo-convex on every line of cross-section and possessing a like function or retroactive force. The specification says: 'It is preferable that the lift be of the same thickness throughout and that its marginal surface be at all points radial to the center of curvature of its concave side 3 so that, when the lift is applied to the shoe heel and subjected to pressure, its said marginal surface will be coincident with the side of the shoe heel.'
>
> "It is conceded by the plaintiff that the preferred form of lift called for by the language—'that its marginal surface be at all points radial to the center of

curvature of its concave side 3'—is spherical. The drawings of the specifications show a concavo-convex lift of spherical form, having a body of uniform thickness and its side and breast edges below a plane passing through its rear upper edge and breast corners."

This matter considered by the First Circuit Court of Appeals as sufficient to describe the preferred form of the invention appears word for word in both the reissue and the original patent. There can be, therefore, no question that the disclosures are the same. The uniform current of authority in this litigation including the opinions of all the Courts was to the effect that the Tufford reissue is a valid reissue until this last decision of the Court of Appeals of the First Circuit which was, as we said, based in fact upon the proposition that a patentee cannot in his reissue patent make a claim broader than the specific embodiment of the invention or preferred form of device disclosed therein.

If that were the law, there would be no such thing as a broadening reissue because no claim in the original patent could be narrower than the specific disclosure and any broader claim in the reissue must, therefore, necessarily be broader than the disclosure. And this Court, with others following, has time and again held that re-issue claims if made within a reasonable time may be broader than the disclosure in the original, else there could be no such thing as a broadening re-issue, which all know are legion with many such sustained by this Court. (*Topliff vs. Topliff*, 145 U. S. 156 and running both ways as far back as *Morey vs. Lockwood*, 8 Wallace, and down to the present time.) It follows that unless claim 8 is thus remade or rewritten, it is infringed. Even the First Circuit Court of Appeals so held in its first decision.

If the word "rear" were read into the last limitation of claim 8 to make the words thereof correspond to the words in the limitation respecting the edge in all the claims

in suit, claim 8 would still be infringed and still be broad enough to include a heel having straight side edges and still come within Defendant's concession of infringement under the decisions of the Sixth Circuit Courts and Judge Brown, for this concession was made of and these Courts held infringement of claims 5, 6, 7 and 9 which do contain the word "rear."

(2) Defendant asks that all the claims in suit be remade against the patentee by reading a limitation out of the claim and substituting therefor a limitation once in the claim but cancelled and superseded by the present different limitation before the patent issued.

Claims 5 and 6 as presented with the amendment of October 27, 1915 (R. p. 254) contained the expression—

> (e) "the concave upper face lying entirely below a plane *tangent to* the rear upper edge and breast corners of the lift." ([10])

Defendant contends that this limitation recites the curved side edge or three-point contact heel. Defendant says that the quoted language described the particular embodiment of the Tufford heel illustrated and described in the patent and having the curved side edge and that the claims in suit containing this expression are so limited. Defendant says that the solicitor said, page 255 of the record, that this language was not descriptive of a straight edge heel. Assuming that this is so, and that if the claims (except claim 8) had issued with the quoted limitation (e) in them, we would be limited to the curved side edge heel. That does not end the matter, however because the claims were thereafter amended again, eliminating this

([10]) Claims 7, 8 and 9 contain the expression with the following variations. The word "rear" was omitted from claim 8 as we have said; also "said" was substituted for "the" before lift and "of the lift" was added after "face." Claim 7 substituted "attaching" for "concave" and claim 9 omitted "upper" before "face."

very "curved edge" limitation from each of them and broadening them to include a straight edged heel. On page 258 of the record *"tangent to"* was cancelled and *"passing through"* was substituted therefor in each of the claims in suit, making the limitation of claims 5 and 6 read as follows:

> (d) "the concave upper face lying entirely below a plane *passing through* the rear upper edge and breast corners of the lift."

According to Defendant's contention, the claim was at its narrowest when it contained the "tangent to" expression (e), for Defendant says that the claims then read specifically to the embodiment of the Tufford invention illustrated and described in the patent in suit. Since the claims were then at the bottom of the wheel, any amendment to this phrase was necessarily broadening. A more narrowing limitation would have made the claim misdescriptive.

In the *Morgan Envelope Case,* 152 U. S. 425, this Court held that a limitation cancelled from a claim could not be read back into the claim after it went to patent, any more than a limitation placed in a claim could be read out after the claim went to patent. Defendant here asks for a violation of both of these rules. In the *Envelope* case, this Court after re-announcing and citing authorities on the second rule said, (page 429),

> "It is true that these were cases where the original claim was broader than the one allowed, *but the principle is the same if the rejected claim be narrower.* Why the claim of the present patent was allowed after the rejection of the narrower claim, does not appear."

Although it clearly appears in the case at bar why the broader claims were allowed after the rejection of the narrower claims, we might well stand upon the proposition

that the broader expression "passing through" cannot be read out of the patented claim and be within the *Envelope* case. The reason why the broader claim was allowed after the rejection of the narrower claim in the instant case appears from the following:

The Examiner defined the term "passing through" as follows. The original reissue application drawing contained a figure like Fig. 12 below, which was Fig. 2 of that

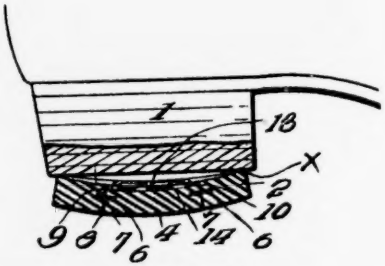

FIG. 12.

drawing. It appeared that there was a line contact between the rubber lift and the heel along the breast line as shown at "X." The Examiner said, in the office action of November 16, 1925 (R. p. 256), that Fig. 2 did not show a structure defined by the limitation (e) then in the claims which contained the expression "*tangent to*" and which we have quoted at the head of this discussion, because, said the Examiner, the reference plane of the claim would then *pass through* the entire front edge of the lift. He said,

> "According to this figure (Fig. 2), a plane tangent to the rear edge and the breast corners would also *pass through* the entire front edge of the lift."

Taking the Examiner at his word that the term "*passing through*" would include a line contact, such as was thought to be shown at "X" in Fig. 12 of this brief, the solicitor amended the claims, striking out the "*tangent to*"

expression which the Examiner had just declared would not describe this line contact, and substituting the term "passing through" which the Examiner had declared would describe the line contact. The claims were thus made broad enough to cover either a curved or a straight edged heel, and since the case no longer contained a claim limited specifically to the curved side edge heel, the applicant added claim 10 which has been held by all of the courts adjudicating the same, to be limited to the curved side edge heel.

The fact that the drawing was amended to make Fig. 2 conform to the other parts of the disclosure and that descriptive matter of the particular embodiment of the Tufford heel disclosed in the application was amplified at the same time, has nothing to do with the case. The suit is on the claims, not on the drawing. Defendant seeks to limit the patent to the drawings. Defendant would heed the amendment to the drawing and ignore the amendment to the claims.

In view of this analysis of the claims, it would seem to be a work of supererogation to genealogize the claims in suit, but as so much has been said on the subject, we will trace the genealogy of claim 5 which, when separated into its elements, reads as follows:

> "A heel lift (a) of substantially non-metallic resilient material (b) having its body portion of concavo-convex form (c) on every line of cross section (d) the concave upper face lying entirely below a plane *passing through* the rear upper edge and the breast corners of the lift."

(1) The reissue application as filed contained a group of claims reciting elements (b) and (c). (R. p. 234.)

For example a claim numbered:

"(5) A cushion heel lift having

(b) a concavo-convex form

(c) on every line of cross section."

These were rejected. The Examiner thought that this limitation did not make the claims patentable over Nerger. Wherever this question has been squarely before the courts in this litigation, the judges have disagreed with the Examiner on this point.

(2) Without acquiescing in this position of the Examiner, but still arguing forcibly against it, the solicitor included claims reciting the elements a, b and c. (R. pp. 248 and 249.)

For example claim—

"(5) A heel lift of

(a) resilient material comprising

(b) a body portion of concavo-convex form

(c) on every line of cross section and normally held in such form by its own inherent resiliency."

(3) The Examiner thought that this expression did not differ from Nerger. The Sixth Circuit Courts ruling on this point have differed with the Examiner.(11) Still

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(11) In an unpublished opinion by Judge Westenhaver in the Tee Pee litigation he said:

"This conclusion renders unnecessary a re-examination of the question whether invention can be based upon Tufford's advance over Nerger merely by eliminating the spring plate which was a material element of the Nerger invention, and *whether a heel lift without the plate, yet constructed in strict conformity to the shape of the heel lift described by Nerger, would be an infringement of any of the claims of Tufford's patent. I held the affirmative of both propositions in Fetzer & Spies Leather Co. vs. I. T. S. Rubber Co. and U. S. Rubber Co. vs. I. T. S. Rubber Co., and do not understand that my conclusions were in either respect criticized or disapproved by the Circuit Court of Appeals but merely that in the latter case the Court preferred to rest its affirmance upon the narrower ground.* Counsel for defendant urge in their brief what seems to me to be conclusive reasons why the conclusions then expressed by me are sound. Such reconsideration as I have since given to these questions confirms me in the belief that my conclusions were correct."

Judge Westenhaver's opinion in the *Fetzer & Spies* case referred to by him was incorporated in the opinion of the Sixth Circuit Court of Appeals (260 Fed. 941). In the *Tee Pee* case that court discussed without deciding this point.

arguing that the claims differed from Nerger, the solicitor added claims (R. p. 254), including Claim 5, which recited the limitations (a), (b), (c) and (e).

"(5) A heel lift
(a) of substantially non-metallic resilient material having
(b) its body portion of concavo-convex form
(c) on every line of cross section
(e) the concave upper face lying entirely below a plane *tangent to* the rear upper edge and the breast corners of the lift."

This claim, when in this form, is said by defendant to be limited to the curved side edge or three-point contact. Assuming that this is so, there is another amendment to be reckoned with for

(4) the claim was again amended (R. p. 258). Amendment (e) with its three-point contact or curved side edge limitation was cancelled out and amendment (d), agreed by the Examiner to be broad enough to include the straight side edge heel, was substituted therefor, and the claim assumed its present patented form, which, when itemized, is as follows:

"(5) A heel lift
(a) of substantially non-metallic resilient material
(b) having its body portion of concavo-convex form
(c) on every line of cross section
(d) the concave upper face lying entirely below a plane *passing through* the rear upper edge and the breast corners of the lift."

Mr. Tufford and his solicitor had, between amendments (3) and (4) labored with the Examiner in oral interviews showing him the Tufford and Nerger heels, mold, etc., and had convinced him of the error of his previous

rejections, for it was then that the broadening of claims 5 to 9 by the elimination of *tangent to* and the substitution of *passing through* occurred. As the last amendment had cleared the case of all claims limited to the curved side edge and as it was desired that the patent should contain such a claim, also claim 10 was added with an avowed statement to that effect. The addition of claim 10 is alone sufficient to rebut the contention that the other claims are so limited and the same. Its addition would have been superfluous were that so.

(3) It is proposed to read "on every line of cross section" into claims 7 and 9. This expression appears in claims 5, 6 and 8, where it modifies both the concave and the convex faces. It does not occur in claim 9 at all. In claim 7 it modifies only the convex face.

It has been held that the term "body portion of concavo-convex form on every line of cross section" occurring in claims 5, 6 and 8 define the so-called "saucer" formed heel and distinguish from the scoop form of the Nerger heel. With this we agree. These three claims differ from Nerger, therefore, in two respects, i. e., the exclusion of the metallic plate and the scoop form.

This limitation was omitted entirely from claim 9. Nothing is said there about the form of the heel. The plan of defining the form was abandoned entirely and the faces were defined. The term "on every line of cross section" was omitted entirely and the following supplied —"the attaching face of which is concave and the tread face of which is convex."

This claim therefore differs from Nerger only in the omission of the plate. The saucer-shaped limitation can be included in the claim only by reading "on every line of cross section" twice into the claim, first, after "concave" and second, after "convex." This, the defendant

asks the court to do that he may escape the charge of infringement.

The liberties proposed to be taken with claim 7 are not so great. It is asked that the limitation be read into this claim only once. Claim 7 like claim 9 omitted the saucer form limitation—"its body portion of concavo-convex form on every line of cross section" and included the following—"a body portion, the attaching face of which is concave and the tread face of which is convex on every line of cross section."

Here, as in claim 9, we find a marked departure from the practice of defining the form as a whole which was followed in claims 5, 6 and 8 and the analysis of the heel into its opposite faces that the desired distinction might be made, showing a clear intention in both claims 7 and 9 to distinguish from the "saucer" limitation of claims 5, 6 and 8. This limitation was in claim 7 omitted from the description of the attaching face, but added to the description of the tread face so that claim 7 differs in this respect from both claim 9 and claims 5, 6 and 8 and from Nerger in reciting both the omission of the plate and the saucer shaped tread face.

That these limitations thus intentionally omitted from claims 7 and 9 cannot be read into them, is conclusively settled by the authorities we have cited, *supra*.

The genealogy of claim 7 repels any effort to read "on every line of cross section" after "attaching face" in that claim.

The original reissue application contained two claims, 5 and 6, (R. p. 234) which read as follows:

—5—

"A cushion heel lift having a concavo-convex form on every line of cross section."

—6—

"A cushion heel lift, the attaching face of which is concave and the tread face of which is convex on every line of cross section."

It is apparent that the draftsmen of the claims did not intend that "the attaching face" in claim 6 should be modified by the expression "on every line of cross section," or that that expression should be read into claim 6, for if that were done, these claims 5 and 6 would be coextensive. Just below these claims appeared original claim 8 which read as follows:

—8—

"A cushion heel lift, *the attaching face of which is normally concave,* and *the tread face of which is normally convex on every* line of cross section thereby to cause the entire margin of the lift to snugly engage the heel of a shoe when said lift is positioned on the heel, and pressure applied to the convex face thereof to flatten said lift."

It would be just as unreasonable and as contrary to the plain intention to read "on every line of cross section" after "concave" in claim 8, as in claim 6.

The original claim 8 was cancelled and reproduced with certain changes as claim 7 on pages 248 and 249 of the record where the expression "the attaching face of which is concave and the tread face of which is convex on every line of cross section" is preserved. This claim 7 was cancelled and reappears with further changes as claim 7 on page 254 of the record, and finally after the amendment at page 258 of the record, as a claim of the patent. The patent claim is, therefore, directly traceable from its inception where the distinction between "concavo-convex form on every line of cross section" and "the attaching face of which is concave, and the tread face of which is

convex on every line of cross section," was clearly made by the examiner.

The genealogy of claim 9 also repels any effort to read "on every line of cross section" into this claim.

At the time that the Examiner was defining the meaning of these various expressions, employing the terms "concave" and "convex," (record pages 234 and 235) claims were inserted using the terms "concavo"-"convex on every line of cross section," "the attaching face of which is concave and the tread face of which is convex on every line of cross section" and "a normally convex tread face, and a normally concave attaching face," which appeared in original claim 10. If "on every line of cross section" had been read into the original claim 10, it would have been co-extensive in substance with original claim 8 presented with original claim 10. The presentation of two claims reciting the same elements and the same function, the one containing and the other not, the term "on every line of cross section" establishes conclusively that this expression was not intended to and could not be read into original claim 10. This latter term was preserved in substance along with the claims using the other two terms throughout the prosecution of the reissue application. Original claim 10, rewritten with some modification, but still preserving the concave and convex statement divorced from the "on every line of cross section" statement appears as claim 8 of the record, page 249. With certain changes, it appears again with the term "concave" and "convex" still divorced from the expression "on every line of cross section," at page 254, as claim 9, and with the further amendment made at record page 259 to this claim, it appears as claim 9 of the patent in suit.

The birth-marks thus acquired by these claims at their inception and clearly defined then by comparison with other

claims, have been preserved throughout the genealogy of the claims and now appear in them as patented. The present attempt to remake the claims under the circumstances violates the clear intention of the draftsman of the claims and the Examiner as well as the rule of law forbidding the remaking of claims.

There is no reason why the claims should be remade. All of them admittedly distinguish from the Nerger patent, the sole survivor of the many patents originally relied upon, in reciting the omission of the metal plate.([12]) If the Examiner thought that such was not a patentable distinction, Judges Westenhaver and Luce, thought so and the Sixth Circuit Court of Appeals assumed that this was so. Mr. Tufford so contended to the end. Claims 5, 6 and 8 admittedly differ from the Nerger patent also by reciting the saucer-shaped limitation.

ARGUMENT: All this technical argument takes no note of the fact that even though the claims were thus remade, there would be infringement under the rule of equivalency. Discussion of solicitor and Examiner, for the most part ambiguous and indefinite, is the main reliance

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([12]) We could not improve upon Judge Westenhaver's finding on this subject (*260* Fed. 945):

> "Moreover, even if the Ferguson or Nerger heel lifts had, in practice, accomplished the same results as the Tufford heel lift, the latter is, in my opinion, still such an advance over the prior art therein disclosed as would amount to patentable invention. The metallic circular washer of the Ferguson and the metallic spring frame with lateral arms of the Nerger heel are obvious disadvantages, and the evidence shows that no rubber heel lift embodying these features is or could be successful in practice. They destroy in large part the resiliency of the heel, which is the main purpose of all rubber heel lifts. They shorten the life of the heel lift, and increase the rapidity with which it wears out. They enhance substantially the cost of manufacture, for a heel lift carrying a metallic plate cannot be molded at a single operation from one piece of rubber, but must be molded in two sections, with two operations."

Since the validity of the claims is admitted, we do not enlarge upon this recital or recount the facts and evidence upon which it is based.

for the contention that the claims be remade to limit the patent to impotency.([13])

Defendant seeks to borrow from the arguments of solicitor and Examiner. The rule at circuit is that these arguments cannot create an estoppel.([14]) The First Circuit Court of Appeals relied in its last opinion largely upon the arguments of solicitor and examiner and its opinion bristles with the court's interpretation of these arguments in support of its restriction of the claims.

Neither remaking nor request therefor was suggested when the admission of validity was made. The plaintiff proceeded in the preparation and submission of his case on the basis that the concession applied to the claims as they appear and Defendant was prompt and vigorous in insisting that Plaintiff's case be so limited. Had we been forewarned by pleadings or other timely advice, we could and would have submitted proof to the effect that "rear" was omitted from claim 8 intentionally and that the Examiner said to Mr. Tufford personally and orally that there was a great difference between the Tufford heel and the Nerger heel, and that he wanted Mr. Tufford to have a broad patent.

([13]) The arguments are grouped as follows:

(1) That Nerger was not concavo-convex on every line of cross section. This does not apply to claims 7 and 9. This expression could not apply to the edges which, of course, are not lines of cross section, but boundary lines. The Examiner did not agree with the Applicant. Whose argument is right then, and which, if either, constitutes the alleged estoppel?

(2) That Nerger's cancavity terminates at the breast so as to leave an opening that prevented the performance of a desired function when the Nerger heel was flattened. This limitation appears in none of the claims. It is proposed to read it in.

(3) That Nerger does not show the concave face of the lift lying entirely below a plane *tangent to* the rear upper edge and breast corners of the lift. This term was once in claims 5, 6, 7 and 9. It never was in claim 8 and is not in any claim in suit.

([14]) *Spalding vs. Wanamaker*, 256 Fed. 530 (C. C. A. 2); *Pangborn vs. Sly*, 284 Fed. 217 (C. C. A. 4).

Such wholesale remaking of claims would be destructive of the examination system of the United States patent practice, for, if the Court is to remake the claims, the work of the Examiner and solicitor is bootless. Neither the public nor the inventor could know the limitations to a patent or how the claims would be turned this way or that, like a nose of wax, by the courts.

The proposed remaking of the claims would come dangerously near to violating if indeed, it did not violate, the well established rule that language in a claim will not be construed to make the claim co-extensive with another claim. It is true that in no case would the verbiage be co-extensive but that is of little moment since substance is the important consideration and remaking the claims as Defendant asks would have the effect of making different claims the same in substance. Reading "rear" into claim 8 would make the limitation respecting the relation of the face to the plane the same in verbiage and substance as in the other claims and would make the claim co-extensive in substance with claim 5. Reading the curved side edge or three-point contact limitation into claim 5 would make that claim for all practical purposes co-extensive with claim 10. Reading "on every line of cross section" into claims 7 and 9 would make those claims co-extensive in substance with each other and with claim 5.

Construction of the claims as they read and without remaking them as Defendant asks, results in a series of claims each differing from the other in substance and each composed of several vital elements. The last element in each claim in suit regarding the position of the attaching face to the plane and over which there is so much controversy describes structure without a re-entrant portion which would prevent the automatic sealing effect. It was important to jettison both re-entrant portions and plates

which would destroy the automatic sealing effect of the patented device.

Nor do the claims, construed as they read and without remaking, seek to recapture what was claimed and cancelled in the original file wrapper. This question was squarely before the Court of Appeals in the Sixth Circuit who in a *per curiam* opinion said (260 Fed. 947):

> "It is said that the substance of the additional claims secured by reissue was asked for and refused in the original application, and hence the reissue was invalid. We do not so interpret the history of the original application."

In view of this we do not think we should burden this Court with an analysis of and a comparison of each of the claims presented in the original application with the five claims in suit. Although the First Circuit Court of Appeals, differed with the Sixth Circuit on this point also, without, however, favoring us with a statement of which claims in the original it thought Plaintiff was seeking to recapture.([15]) It would seem sufficient to call attention to

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([15]) The only suggestion on this point found in the opinion of the First Circuit Court of Appeals is the statement on page 782 of Federal Reporter 1, Second Series, as follows:

> "The proceedings in the Patent Office clearly disclose that the claims in the original application, covering a heel having a concave attaching face and its upper side edges, breast corners, and its rear upper edge lying in the same plane, were disallowed upon references to prior patents; that he acquiesced in such rejection; and that such acquiescence was not occasioned by inadvertence or mistake."

The claims referred to were, of course, much broader than the language quoted. They were broad enough to cover a heel having both the straight edge and the curved edge. They were broad enough to cover the defendant's heel and the plaintiff's heel. It would be just as reasonable to assume that claims limited to the curved side edged heel were invalid in the reissue as to assume that claims covering the straight side edged heel were invalid in the reissue because of these broad claims which were presented in and cancelled from the original application. We recognize the rule that a claim presented and cancelled cannot be recaptured by the reissue, but this rule does not forbid the making in the reissue of a limited claim when a claim had been cancelled from the original application which was broad enough to cover a device described by the limited claim in the reissue. Applicant does not, under such circumstances, seek to recapture what has been presented and cancelled.

the fact that not a single claim in the original application specifically excluded the plate or recited the element in the claims in suit which relates to the position of the attaching face with respect to the reference plane whether such element be left as it reads in the claim or amended as Defendant asks. The violation of the claim as Defendant proposes makes no difference in that respect. In addition to these common recitations, individual claims recite subject matter not recited in any claim in the original application. Each claims 5, 6 and 8 recite "concavo-convex on every line of cross section." Claim 7 recites "convex on every line of cross section." Claim 6 recites "the location of the nail openings near the center." Claim 7 recites "normally held in such form by its own inherent resiliency." Claim 8 recites "a body portion of uniform thickness."

The only claim in the original application which mentions the edges are the claims on page 272 of the record as amended and as amended these claims are misdescriptive since Mr. Tufford's application did not disclose a heel having all its edges occupying the same plane. The claims were void because not supported by the disclosure. It is difficult to conceive of accident or mistake more worthy of correction by reissue than that resulting from the presentation in the original of misdescriptive claims. It also follows, *ipso facto*, that there is no effort to recapture these claims.

The amendments to the specification and to Fig. 2 of the reissue drawing (R. pp. 257 and 260) did not change the disclosure. The former supplemented the description of the particular spherical embodiment disclosed in the original specification and the latter caused Fig. 2 to conform to the other figures of the drawing. The fact that broad terms used are said to describe the particular em-

bodiment shown does not negative the fact that such terms also describe other structures embodying the essential principles of the invention. All through this litigation, the Defendant has asked that Mr. Tufford be limited to the particular embodiment illustrated and described in his patent and denied equivalents because of these amplifying amendments. Not even the First Circuit Court of Appeals sustained this contention (281 Fed. 5).

It has also been insistently contended that the edge of the heel is a part of the heel's face, and therefore the edges must be below the reference plane. Even the Court of Appeals in the First Circuit rejected this contention. As that court pointed out, the claims say that the rear edge is in the plane and therefore applicant intended to define the edge as not a part of the face because the face is said to be below the plane and the rear edge in the plane. (281 Fed. 8.) If the edges were a part of the face, the rear edge would then be both in and below the plane.

The courts have, and this Court probably will be bombarded with these specious technical arguments all designed to draw attention away from the substance and the merit of the invention and its history, and to narrow the protection due the inventor. This Court has recently (261 U. S. 63) restated the rule that a meritorious invention will not be whittled away by legal technicalities. The three trial Judges, Westenhaver, Brown and Luce were close to the devices themselves. They saw the devices operated and heard the witnesses. The usefulness of Mr. Tufford's discovery and the advance he made in the art were clearer to them. This accounts for their liberality. The Courts of Appeals saw and heard none of these things. The rubber exhibits have hardened and dried in the years intervening between trial and hearing on appeal and hence

we now get from them an inadequate appreciation of the usefulness and the advance of the patented invention. The commercial history of the Tufford heel supports the conclusions of its usefulness and advance found by these three trial Judges and its right to a liberal construction.

VIII.

CONCLUSION: Defendant's proposition is plain and daring. Defendant appropriates the substance of an invention which is meritorious and useful and which has substantially advanced this art and which invention is admittedly covered by a valid patent. To relieve itself from its embarrassment, Defendant asks this Court to remake the claims against the patentee, that there may be no infringement where infringement otherwise exists. Nothing warrants so radical a change in the administration of the patent law and one which this Court has herebefore repeatedly refused to make, even to save claims, which stood invalid because of this Court's refusal to remake them.

On the other hand, the claims are entitled to a liberal construction, if such were necessary to hold infringement, because of the usefulness of the invention and the substantial advance made by it and the indubitable appropriation of its substance by the Defendant. The mere fact that there are three different judicial interpretations of the file wrapper already establishes that doubt about a technical matter which is always resolved in favor of a meritorious invention.

IX.

Res Adjudicata: It is contended by the Plaintiff that the conduct of the Essex Company, Defendant here, in participating in and controlling and paying all the expenses of the suit brought by Plaintiff against Wendt

& Company of Detroit, Michigan, a customer of the Essex Company, on the Tufford patent in suit, including the payment of all the expenses of the nominal Defendant, the amount awarded as profits and all counsel fees, with the full knowledge of the Plaintiff that said Essex Company was so doing, amounts to a complete estoppel upon Defendant to deny to any extent the validity of the Plaintiff's Tufford patent, or to deny that the heels charged to be an infringement in the present case are in fact an infringement of the Tufford patent, such heels being identical with the heels restrained in the Wendt case.

The proceedings in the Wendt case were specifically as follows:

I. The Bill of Complaint, Order to show cause why preliminary injunction should not issue, and supporting affidavits were filed April 1st, 1920. (R. p. 183.)

II. Service of the Bill, the Order to show cause, and the affidavits on Wendt on April 6th, 1920. (R. p. 183.)

III. Wendt immediately notified the Essex Company of the suit. (R. p. 296.)

IV. Essex Company notified its New York patent attorneys, the Varney firm. (R. p. 344.)

V. The Varney firm appoints the firm of Angell and Turner, of Detroit, to act as its local solicitor in behalf of the Essex Company. (R. p. 156.)

VI. Angell and Turner, not yet of record, as counsel for Essex, procures consent to adjournment of hearing on injunction (Telegram April 16, 1920, R. p. 156, letter April 26, 1920, R. p. 155). (R. p. 298.)

VII. Mr. Whittemore, one of Mr. Varney's partners goes to Detroit and examines papers and exhibits and searches for a missing exhibit heel in the case. (R. p. 155.)

VIII. Direction by Essex New York attorneys to Angell and Turner to handle the Wendt case (Letter July 30, 1920, R. p. 151).

IX. Angell asks Varney for further instructions. (R. pp. 154, 150.) Such instructions given (R. pp. 153 and 147). Varney instructs Wendt through Angell what to do in suit. (R. p. 153.)

X. Essex Rubber Company guarantees Wendt against all expenses that he might be put to in the suit. (R. p. 297.)

XI. The Essex Company notified Wendt that it would not defend the suit, but would allow the same to go by default. (R. p. 11.)

XII. Accordingly, Angell and Turner did let the case go by default. (R. p. 155.)

XIII. Decree *pro confesso nisi* was entered June 17, 1920. (R. p. 189.)

XIV. A letter from Angell and Turner to Mr. Varney dated October 1, 1920, (R. p. 150) announcing agreement as to terms of settlement of case between Angell and Turner and attorneys for the Plaintiff.

XV. A letter from Mr. Varney to the Angell firm dated October 4, 1920, approving the terms of settlement.

XVI. Stipulation regarding the settlement and stating the terms thereof, and waiving appeal from the final decree of the court in the case signed by counsel for plaintiff and Angell and Turner, counsel for Defendant, entered November 1, 1920. (R. pp. 192 and 193.)

XVII. Final decree entered November 1, 1920, pursuant to the stipulation embodying the substance thereof and holding the patent valid and infringed by the sale of Plaintiff's Exhibit, Defendant's heels, "Tight Edge," as to claims 5 to 10, inclusive, of the patent. (R. p. 193 *et seq.*)

XVIII. The Essex Rubber Company paid through Mr. Wendt the amount of the judgment, the court costs, the local attorneys of Mr. Wendt, and their own attorneys, Angell and Turner, and the Varney firm. (R. pp. 299 and 307.)

XIX. On April 20, 1920, the Essex Rubber Company wrote to Mr. Wendt that the Varney firm was leaving Judge Angell to take care of the interests of the Essex Rubber Company for the present. (R. p. 136.)

XX. On April 13, 1920, the Essex Rubber Company wrote to Wendt, instructing Wendt to be careful to instruct Wendt's local attorney that he should not appear as representing Wendt. (R. p. 133.)

It thus appears, from the foregoing, that Wendt a customer of Essex was instructed by Essex to take no action in the suit, but to suffer a default; that Angell and Turner were employed by Essex to represent their interests; that they took action, by way of stipulations, amounting to a general appearance in the case; that they arranged with counsel for Plaintiff upon the terms of a decree for money in settlement of the cause; that they entered into a stipulation as to those terms and, waiving an appeal, from any decree that might be entered; that a final decree was entered to which they consented, as appears in the body of the decree, in which decree the patent was found valid and infringed by the sale of heels identical with those charged to be an infringement in the instant case and in which there was awarded to Plaintiff, as profits, the amount agreed upon in the stipulation, and which decree also directed a perpetual injunction against the Defendant.

In fine, it appears that the Defendant Wendt was instructed to default and do nothing, which instruction he followed, and the Essex Company, through attorneys of

its selection, directed and controlled all that was done in the case down to the entry of the final decree for and on behalf of the Essex Company, receiving their compensation from the Essex Company and from no other source. The Essex Company, therefore, had control of the defense of this suit, if anybody did, from start to finish, and was as clearly in privity with the nominal Defendant, Wendt, its customer as it is possible for one to be, who is not actually, in name, a party to the record.

There can be no doubt as to the identity of causes of action and of the infringing devices in the two suits. In the Wendt suit claims 5 to 10, inclusive, of the Tufford patent were declared valid and infringed and the infringing heels Plaintiff's Exhibit Defendant's Heels, "Tight Edge" were identically like the heels charged in the present case to be infringements (R. pp. 185, 187, 323, 324 and 32), and were heels in which the side edges were straight and not curved. Hence the final decree in this Wendt case determined for all time as between the Plaintiff and the Essex Company as privy to that suit, that heels having all the other characteristics of the Tufford heels as well as straight side edges are infringements of the Tufford patent. To complete the estoppel, it appears that the Plaintiff knew all the time that the Essex Company was defending and controlling the suit against Wendt and that Wendt had no control or say in the matter. (R. pp. 287 and 288.)

Respectfully submitted,

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No. 229

Office Supreme Court, U. S.
FILED
DEC 31 1925
WM. R. STANSBURY
Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1925

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI DIRECTED TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

BRIEF FOR THE RESPONDENT.

LUCIUS E. VARNEY,
of Counsel for Respondent.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1924.

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,
Respondent.

BRIEF FOR RESPONDENT.

Respondent agrees that the Court in the Sixth Circuit has given the patent a broader scope than was accorded by the Court below; but this difference in scope is purely academic, for practically and commercially it is of no importance. The petitioner itself has so maintained in the Tee Pee case, *Tee Pee Rubber Company* v. *I. T. S. Rubber Company, 268 Fed. Rep. 250, 257;* and no rubber heel manufacturer today would consider it an advantage to substitute the narrower interpretation of the Court below for that of the Sixth Circuit which all manufacturers, including this respondent, have adopted and followed in commercial practice ever since it was announced (1919). *U. S. Rubber Co.* v. *I. T. S. Rubber Co., 260 Fed. Rep. 947.*

The rubber heel-lifts to which the patent relates are concavo-convex in shape before being applied to a shoe-heel. In every case where the patent has been litigated, it was either conceded or found that the patent was valid for a particular variety of concavo-convex lift. This variety was characterized by the curvature of the upper and lower faces of the lift which is that of a sphere, or substantially so, and which normally results in making the sides of the lift arched instead of plane or straight. This patented shape has accordingly been denominated by the Courts as "spherical" and the patented heel-lift resulting therefrom as the "three-point contact heel"; and, as just noted, this heel was in every litigated case either conceded or found to be within the petitioner's monopoly.

The only question between the Sixth Circuit and the First Circuit was as to the test to be laid down for determining whether a heel-lift was within this monopoly or not. In the Sixth Circuit, the Court thought and held that the peculiar shape of petitioner's lift was inherent in any concavo-convex lift which was "saucer-shaped" as distinguished from "scoop-shaped"; it found that the nearest patent in the prior art (Nerger) had a relatively low-breast edge making Nerger's lift "scoop-shaped"; and it therefore laid down the determining criterion of infringement to be the height of the breast edge of the lift with respect to its upper face. If the breast was high enough to make the heel "saucer-shaped" rather than "scoop-shaped", then there was infringement irrespective of any other considerations. In the First Circuit, the Court thought and held that the patent was limited to the arched side

edges which, as before noted, everybody concedes to be within the petitioner's monopoly.

In stating it, the difference between the two decisions may seem substantial; but when translated to the heels themselves, it is very slight indeed, so slight, in fact, that it is often difficult to determine. It is simply this: a concavo-convex rubber heel-lift with a low-breast edge is not an infringement anywhere; one with a high-breast edge is an infringement in the Sixth Circuit but not in the First in the absence of the other patented features conceded by everybody.

Following the holding in the Sixth Circuit which came down in 1919, all rubber heel manufacturers, including this respondent, accepted that decision and the criterion of infringement laid down and thereafter made the breasts of their concavo-convex heels low so as to avoid infringement.

Following shortly on this, the Tee Pee case, aforesaid, came before the Court in the Sixth Circuit. There, the petitioner maintained that the Tee Pee heel, which had a low-breast, nevertheless acted the same as the patented (Tufford) heel, that is to say, the two heels were alike in function and results. To this contention, that Court, finding non-infringement, replied as follows, 268 Fed. Rep. 257:

> "If it may be true that sufficiently skillful manipulation of the Tee Pee lifts will make them for a time and in a degree, act like the Tufford lifts, and if it should therefrom be inferred that this distinction in shape between Tufford and the Tee Pee is immaterial, the further inference will be inevitable—since the Tee Pee must be classed with Nerger (prior art) as to this shape—that

there was no substantial distinction in this respect between Nerger and Tufford, and that Tufford and the Patent Office were wrong in the theory upon which alone issue of the Tufford patent was procured."

Respondent believes therefore that this petition should be denied because the difference between the two decisions, when translated into the heels themselves, becomes, as heretofore contended by the petitioner itself, inconsequential. This conclusion is also confirmed by the fact that no rubber heel manufacturers since 1919 have ever considered it an advantage to put out concavo-convex heels with a high-breast edge. When the Court of the Sixth Circuit drew the line between a high-breasted heel and a low-breasted one everybody accepted it,—there was immediate acquiescence.

The decision in the First Circuit came about in this way. This suit was begun in June, 1920, after respondent had ceased to manufacture high-breasted heels following the decision of the Court in the Sixth Circuit. When sued, therefore, respondent was only putting out low-breasted heels which it has continued to do ever since. But being sued on the theory that both the high-breasted heels and the low-breasted heels were infringements, it defended on both,—it was necessary to defend on the high-breasted heels in order to avoid damages for past infringement. It has succeeded in its defence of both forms of heels.

But respondent does not wish to go back to the high-breasted heels even though the decision below permits it to; indeed, respondent would consider it a hardship if it were required to do so. Its low-breasted heel meets all the requirements

of the trade for this type (concavo-convex) of rubber heel; and that is what all rubber heel manufacturers have found. Nobody wishes to put out high-breasted heels,—everybody is willing to accord to the patent that field, in accordance with the decision in the Sixth Circuit, simply because there is no advantage in invading it.

But, naturally, the petitioner itself is anxious for more—to it the decision in the Sixth Circuit is really no better than the decision in the First. It realizes, as it maintained in the Tee Pee case, that even the broader decision does not help it commercially because of the fact that there is no practical advantage in the behavior of high-breast heels over low-breast heels. What the petitioner wants is a chance to argue again, as it did in the Tee Pee case, aforesaid, that its monopoly should be independent of this criterion, that is, that it should include both high-breast heels and low-breast heels—something neither Court would concede.

Respondent submits that the opinions alone in this case and in the cases referred to clearly show that that is what petitioner is after and that the difference between the decisions in the First and Sixth Circuits is wholly unsubstantial and trivial and of no practical importance either to petitioner or the public and is merely being used as a pretext for a further hearing.

Respectfully submitted,

L. E. VARNEY,
Of Counsel for Respondent.

New York,
Dec. 30, 1924.

MAR 8 1926
WM. R. STANSBURY
CLERK

Supreme Court of the United States

OCTOBER TERM, 1925.

No. 229.

THE I. T. S. RUBBER COMPANY,
Petitioner,

vs.

ESSEX RUBBER COMPANY,
Respondent.

BRIEF FOR RESPONDENT

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1925.

No. 229.

THE I. T. S. RUBBER COMPANY,
Petitioner.

vs.

ESSEX RUBBER COMPANY,
Respondent.

JURISDICTION.

This patent case comes here from the first circuit, certiorari having been allowed because a different interpretation was given to the patent in the sixth circuit. This difference is discussed *infra*, p. 43.

The final decree of the court below was entered October 23, 1924 (Rec. p. 362); the petition for certiorari was filed December 22, 1924 and allowed January 12, 1925.

The Patent in Suit.

The validity of the patent in suit was conceded in the answer (Rec. p. 10), infringement alone being denied.

The patent in suit (Tufford patent, copy inserted at page 164 of the record) is a reissued patent entitled *Resilient Heel.* It covers what is more correctly called

a *heel-lift* which is generally about one-half the thickness of a whole heel, is made of rubber, and is nailed to the heel proper (shoe heel) to provide a yielding, as distinguished from a rigid, heel. As such, rubber heel-lifts are in common use and have been known for many years.

These heel-lifts are of two types, the flat type and the concavo-convex type. Both were old when Tufford made his invention. The flat type is cemented to the shoe heel and then nailed, the cement being used to prevent the rubber heel, in use, from working away from the leather heel around the edges. The concavo-convex type is secured to the shoe heel without the use of cement by placing the concave side thereof against the shoe heel, pressing the same flat against the shoe heel, and nailing. The distortion of the rubber produced by pressing the curved heel down flat and so maintaining it by nailing, tends to keep the edges of the rubber lift tightly pressed against the shoe heel, thus making cementing unnecessary. This distinguishing characteristic of concavo-convex heel-lifts is often referred to as a "tight-edge effect" and was known and alluded to as far back as 1899 in Ferguson's patent No. 638,228 (Rec. following page 280) in the following terms:

> "It is obvious that when the concavo-convex heel-section is screwed tightly against the leather heel surface said heel-section will thus be forced to assume the straight or horizontal form of the leather heel-lifts, and owing to the natural tendency of said heel-section to assume its normal curved form it will be seen that the tendency of the raised marginal portion will be to cling closely to the surface of the leather, thereby overcoming the usual tendency of

rubber heel attachments toward lifting up or separating from the leather at the edges."

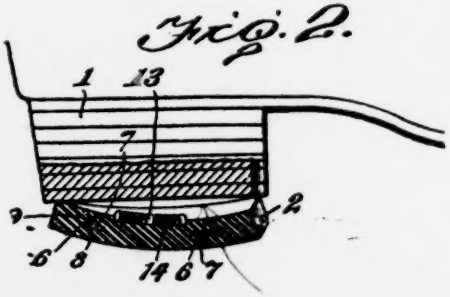
The Tufford heel-lift belongs to the concavo-convex type; and it is obvious that when Tufford filed his original patent application (September 15, 1914), he was only entitled to cover such specific improvements in concavo-convex heel-lifts as he had devised.

Tufford's improvements, as he sets them forth in his patent, are of three kinds. The first has to do with the fastening means which he claims to have improved by providing peculiarly shaped metallic washers through which the nails pass; the second has to do with channels or grooves formed in the concave attaching face; and the third has to do with the form or shape of the heel-lifts themselves.

The first and second of these alleged improvements are covered in claims 1 to 4 inclusive of the patent; and the third, the shape-defining improvements, are covered by claims 5 to 10 inclusive. Since the bill of complaint (Rec. bottom of page 6) limits the charge of infringement to claims 5 to 9 inclusive, we have only to consider these particular claims and the part of the specification which defines the shape or form of the lift upon which these claims are based.

Claim 5, which is typical of the claims in suit, is as follows:

> "5. A heel lift of substantially non-metallic resilient material having its body portion of concavo-convex form on every line of cross section, the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift."



Reproduction of Figure 2 of the patent in suit, illustrating a shoe-heel with one of the patented rubber lifts placed in the relation which it occupies thereto before it is flattened down and secured against the shoe-heel. This cut is a longitudinal section taken through the center of the shoe-heel and hence only shows half of the rubber lift. Note particularly that the upper side-edge of the lift, denoted by the arrow, does not contact with the shoe-heel, but is subtended below the plane of the underside of the shoe-heel.

This claim is not difficult to understand even without the specification or drawing; but reference to figure 2 of the patent (reproduced opposite) shows clearly the shape which the patentee had in mind. Figure 2 is described in the patent as "a front to rear sectional view through the lift in position disposed against the under side of a shoe heel and immediately prior to application thereto." It shows that the upper side edges of the rubber-lift, one of which edges is indicated by the arrow in the cut, are arched below the leather heel and hence do not touch the leather heel until the lift has been pressed down and flattened against the leather heel. Before the rubber lift is flattened by being pressed onto the leather heel, it touches the leather heel only at three points,—at the rear end and at the two breast corners; and for this reason is often referred to as the "three-point-contact" lift.

When therefore the claim states that the patented lift has "the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift", we understand at once that Tufford refers to this arching of the sides so that the lift, when brought in contact with a shoe heel and before being flattened, touches the shoe heel only at the rear upper edge and the two breast corners,—*i. e.*, at three points which define a plane below which all the other points in the upper concave face lie.

If there were any doubt about this interpretation of the clause, we have only to turn to line 91 of page 2 of the specification (Rec. following p. 164) which is as follows:

"By references to Figs. 2 and 4 of the drawings, it will be seen that the concave upper face of the lift lies entirely below a plane passing through the rear upper edge and breast corners of the lift whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when the lift is positioned on the heel and the convex face thereof depressed to flatten said lift. *In other words, owing to the curvature of the concave attaching face of the lift, the rear upper edge and breast corners of said concave attaching face are disposed in a plane above the upper side edges and the breast edges of the lift.*"

We have italicized the last sentence in the above quotation to call particular attention to the very specific and definite meaning which Tufford assigns to this particular clause in all of the claims under consideration. He means to have it clearly appear in his patent that this clause in the claims defines a structure in which *the upper side edges of his heel-lift lie below the reference plane*, which is a very characteristic structure and differentiates the Tufford lift, as we shall later show, from the prior art.

For example, we shall point out later when discussing the file wrapper (*infra*, p. 17), how Tufford inserted this italicized portion of the specification during the prosecution of his application in the patent office and while it was under rejection upon Nerger's patent of November 6, 1900 (Rec. following p. 280), which shows a lift with its upper side edges in a single plane, that is, without any arching and precisely like the side edges of respondent's lifts.

The question is then,—and we think it is the only substantial question in this case, since the validity of the Tufford patent has been admitted in respondent's answer—whether the Tufford patent, and particularly claims 5 to 9 thereof, can be held to cover any concavo-convex rubber lifts except the three-point-contact lifts, that is, those which have the arched side edges so defined in these claims, illustrated in the drawing, and very particularly and definitely described in the specification.

This court, particularly, in a long line of decisions*, has called attention to the fact that one important function of letters patent for inventions is to inform the general public precisely what the patentee has covered by his monopoly and precisely what field is left open for exploitation by others. These decisions point out that when the patentee has explained and claimed his invention in plain language, the public may rely upon that plain language and may safely contract and otherwise do business upon the assumption that the patentee will be held to what he plainly describes and claims as his invention even though it may later appear that his invention was actually broader in scope than he thought when he drew his patent.

This is the very simple case of a rubber heel. There is nothing technical or difficult in the language used

*See for example:

McClain v. *Ortmayer*, 141 U. S. 419; *Brooks* v. *Fiske*, 15 How., 212, 214; *Bates* v. *Coe*, 98 U. S., 31. See also *Evans* v. *Hall Co.*, 223 F. R., 539, 541; *O. H. Jewell Co.* v. *Jackson*, 140 F. R., 340, 347.

to describe it and no reason at all why the patentee's perfectly plain language should not prevail. Anyone familiar with the English language can read and understand the patent and therefore should be safe in acting upon it. Indeed, if the decisions of this court just alluded to can be applied at all, it would seem that they must be applied here.

Rule of Equivalents.

But petitioner has contended in both courts below that under the doctrine of equivalents, Tufford has a right to extend his patent to cover other shapes of heel-lifts provided they function the same way and realize the same advantages and results. But the rule of equivalents cannot be so applied (*Westinghouse* v. *Boyden Power Brake Co.*, 170 U. S. 537, 568-569; *Hubbell* v. *United States*, 179 U. S. 77, 86); for the rule always requires the patented *combination* to be present in some form. If, for example, a claim has three elements, each of these three elements must be found in an infringing structure. One or more of the elements, it is true, may have a different form from that prescribed in the patent; but each and every element must be present and perform the same function, service or purpose as the corresponding element of the claim.

We have nothing of that kind in this case. What the petitioner wants the court to do is to read the arched side edges out of the claim altogether, leaving nothing substituted for this feature; for the moment the location of these side edges becomes unimportant, that moment the last element of the claim drops out entirely. Nothing is substituted for it and hence there is nothing left to perform the same function as that element of the claim. To say, as petitioner does, that the heel-lift *as a whole* functions in the same way and realizes the same results and advantages as the patented heel-lift *as a whole*, is simply to say that a heel-lift having all but the last element of the claim is just as good as a heel-lift having all the elements of the claim. Such situ-

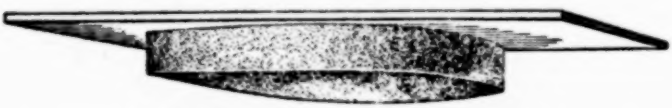
ations have arisen before: but this court has always held that *unless all the elements of the claim are present there is no infringement.*

This rule is so familiar that it is not believed necessary to add any citations; instead, the court is referred to article 349 of *Walker on Patents* and the cases there cited, where the rule is stated as follows: "A combination is an entirety. If one of its elements is omitted, the thing claimed disappears. Every part of the combination claimed is conclusively presumed to be material to the combination, and no evidence to the contrary is admissible in any case of alleged infringement. The patentee makes all the parts of a combination material, when he claims them in combination and not separately."

Comparison of the Patented Heel-Lift With Respondent's Heel-Lift.

Petitioner's commercial heel-lift made under the patent in suit has always been of the three-point-contact type, that is, formed with its side edges arched as illustrated on the opposite page, whereas all respondent's heel-lifts have been made with their upper side edges lying all in the same plane. For comparison, one of respondent's heels is also illustrated on the opposite page, both heels being there shown in relation to the reference plane passed through the two breast corners and rear edge.

Petitioner's commercial heel-lift made under the patent in suit, shown in its relation to a plane passing through its breast corners and rear upper edge. This cut shows clearly why the patented heel is called a three-point-contact heel.



Respondent's heel-lift shown in its relation to a plane passing through its breast corners and rear upper edge. It will be noted that the reference plane necessarily passes through the entire upper side and rear edges because all of respondent's heels are made with their upper side and rear edges in a single plane.

Dismissal on Face of Patent.

This case was originally heard by the district court on a motion to dismiss. The motion to dismiss was brought on in this wise: the respondent sought and obtained, by a bill of particulars, a stipulation defining the precise heels upon which infringement was based; it then moved to dismiss the bill on the ground that it was apparent from the face of the patent that the heels thus alleged to infringe, each of which had its upper side edges in the same plane, could not possibly infringe the claims in suit, and that no evidence could be introduced which would change what was apparent upon, and conclusively fixed by, the face of the patent. (For stipulation and proceedings on motion to dismiss, see Rec. pp. 8, 9.) This motion was granted and the bill dismissed by Anderson, *J.*, who filed a carefully written opinion which is not included in the transcript but is reported in 270 Fed. Rep. 593.

We particularly call Judge Anderson's opinion to the attention of this court because we think that the scope of the patent, which is the only issue here, can and should be determined from the face of the patent without considering the extraneous matters which were offered in evidence.

The practice of determining simple questions of infringement at the outset on motions to dismiss was first established by the court of appeals for the seventh circuit in *Bronk* v. *Charles H. Scott Co.*, 211 Fed. Rep. 338, where it was pointed out that the purpose of the new equity rules permitting a defendant (by bill of particu-

lars or interrogatories) to get into the record of the case at the outset precisely what is claimed to infringed, was "to enable the court to make a summary disposition of a cause by applying the law to an admitted state of facts." In a simple patent case, where the terms of art are clear, where there is no need of expert testimony to explain the functions and operation of a machine or to elucidate some technical matter, and where it appears that no additional evidence whatever could possibly make the clear terms of the claims cover the alleged infringing device, the new equity rules certainly offer an opportunity for a summary disposition of the case. Rule 29, when invoked in such a case, permits the district court to decide whether, in its opinion, the case can probably be disposed of on the face of the patent or whether it should be held for trial on pleadings and proof.

Take the present case, for example. Judge Anderson thought it could be disposed of on the face of the patent for non-infringement, and he accordingly dismissed the bill before any proofs were taken (Rec. p. 9; opinion in 270 Fed. Rep. 593). The court of appeals reversed the decree so entered, on the ground that the plaintiff (petitioner) should have been permitted to take proofs, and so sent the case back for trial (281 Fed. Rep. 5). After the case was heard on pleadings and proof, Bingham, *J.*, for the district court reached the same conclusion as Anderson, *J.*, had previously reached, namely, that there was no infringement; and so the bill was again dismissed. Thereafter, the court of appeals affirmed the decree on the same ground, *viz.*

non-infringement. Thus, the same conclusion was reached by both the district court and the court of appeals on pleadings and proof which Anderson, *J.*, at the outset, had reached on the face of the patent alone by the summary procedure approved in *Bronk* v. *Scott Co., supra.*

The advantage of that summary procedure is that many simple patent cases may be disposed of without the expense of taking proofs which, in patent cases generally, is very burdensome. We realize that, oftentimes, attempted short cuts in litigation result in more expense in the end. But the discretion vested in the district courts under rule 29, permitting those courts to hear the merits of a motion to dismiss or to hold the case for pleadings and proofs according as one or the other of these courses seems best upon a general survey of the case presented by the motion, would seem to go far toward making this a salutary practice *in simple patent cases.*

Since the publication in the *Federal Reporter* of Judge Anderson's opinion dismissing the case, on motion, for non-infringement, counsel for respondent has had many communications from members of the bar concerning this procedure; and it is believed that the approval of this court would go far toward encouraging the bar and the courts to use this summary method wherever possible in simple patent cases. Disapproval of this method and the reversal of Judge Anderson by the court of appeals in this case, if it stands, will tend just the other way.

The File Wrapper Defense.

It has already been pointed out that the patent in suit is a reissued patent, the original patent being No. 1,110,730 dated September 15, 1914 (copy in the Rec. at page 236). Both the file wrapper of this original patent as well as the file wrapper of the reissue patent are in the record. The former is printed beginning at page 263 of the record and the latter beginning at page 229 of the record.

On page 26 of the record, the district court's (Bingham, *J.*) very clear summary of this defense is stated as follows:

> "In the reissued patent he first sought claims for 'a heel lift having a concavo-convex form on every line of cross section'—very broad claims, and in nowise limited as to character or location of the edges of the attaching face of the heel. He was denied these. He then asked for claims somewhat more limited, calling for 'a lift of resilient material comprising a body portion of concavo-convex form on every line of cross-section and normally held in such form by its own inherent resiliency', but so far as the character and location of the edges of the attaching face were concerned equally as broad as the first asked for. These claims were denied and he acquiesced. Finally, on October 13, 1915, he submitted five claims substantially like those previously submitted but all containing the clause 'the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift' or its equivalent, which defined the character and location of the edges of the attaching face.

"Such being the case, it necessarily follows that claims which were allowed with the qualifying clause cannot be construed broadly and to cover what would be embraced within the claims as they stood June 22, 1915, or October 13, 1915; for to do so would render the qualifying clause meaningless and give to the present claims an interpretation such as the plaintiff would only have been entitled to had the earlier claims of June 22 and October 13, 1915, not been rejected. The patentee having narrowed his claims by the insertion of the restricting clause, in order to obtain any claims under the reissued patent, cannot by construction or by resorting to the doctrine of equivalents, give the claims the larger scope which they might have had without the restricting clause. Weber Electric Co. *v.* Freeman Electric Co., 256 U. S. 668, 677. Having acquiesced in the rejection of the claims as offered on June 22 and October 13, 1915, he is now estopped from claiming the benefit of those claims or such a construction of his present claims as would be equivalent thereto. Morgan Envelope Co. *v.* Albany Paper Co. 152 U. S. 425, 428, 429. Thomas *v.* Rocker Spring Co., 77 Fed. 420."

There are two points to be noted in considering the file wrapper:

First, that the patentee, Tufford, by reissuing his original patent, sought to add thereto broad claims which, had they been granted, would have given him a monopoly of every heel "concavo-convex on every line of cross-section", that is, irrespective of any other limitation whatever; but the patent office refused to allow any claim as broad as this and forced him to restrict his

claims by the addition of a qualifying clause defining the location of the upper side edges of the lift with reference to a plane passing through the two breast corners and upper rear edge.

Second, that the meaning of this qualifying clause is not open to question because the proceedings in the patent office show precisely what that clause was understood to mean when it was inserted both by the patentee and the patent office. As was stated by this court in *Goodyear Dental Vulcanite Co.* vs. *Davis,* 102, U. S. 222, 227,

> "when a patent bears on its face a particular construction, inasmuch as the specification and claims are in the words of the patentee, it is reasonable to hold that such a construction may be confirmed by what the patentee said when he was making his application. The understanding of a party to contract has always been regarded as of some importance in its interpretation."

In the present case, the file wrapper not only shows how the patentee and the patent office understood the qualifying clause, but also shows that it was only after Tufford had changed his drawing so that the heel-lift illustrated in the drawing would exactly conform to the three-point-contact interpretation of the qualifying clause, that the patent office would allow the claims in issue here.

With regard to the first of these two points, it is only necessary to draw attention to the following portions of the file wrapper of the reissue patent:

(1) Rec. pp. 233, 234, where are set forth the claims asked for when the reissue application was filed. The first four of these claims are the four claims granted and issued in Tufford's original patent. The remaining six claims are the additional claims asked for in the reissue application, of which claim 5 is to be particularly noted, being as follows:

> "A cushion heel lift having a concavo-convex form on every line of cross-section."

By inserting that claim, plaintiff in fact asked for a monopoly of every rubber heel-lift which was concavo-convex on every line of cross-section irrespective of whether it was of the three-point-contact form or not, or had a metal plate embedded therein or not, or, indeed, had by other characteristics whatever.

(2) Rec. p. 238, which shows that all of the claims except the first four (which had been granted in the original patent), were rejected. Rec. p. 243, which shows that this rejection was again repeated after the patentee had replied to it. Rec. p. 245, which shows that claims 5 and 6 were cancelled and the remaining rejected claims amended and submitted again with an argument which appears on pages 246 and 247. Rec. p. 248, which shows that the amended claims were a third time rejected, this time on Nerger's patent of November 6, 1900. Rec. pp. 248, 249, which show that in view of this rejection upon Nerger's patent an entire new set of claims were substituted for all of the claims except the first four which, as before noted, had issued in the original Tufford pat-

ent. Rec. p. 252, which shows that these new substituted claims were also rejected upon Nerger's patent.

(3) Rec. p. 254, which shows that again an entire new set of claims were substituted for all of the claims except 1 to 4 and that each of these new claims contains for the first time a qualifying clause defining the position of the concave upper face with reference to a plane. Incidentally, this qualifying clause is exactly the same as that in the claims here sued on with the exception that the words, *tangent to,* appear in the place of the words "passing through".

Summarizing, at this point: It appears that the patentee had so far obtained the allowance of no claims beyond those secured in his original patent, namely, claims 1 to 4, and that to meet the citation of Nerger's patent he was obliged to add the qualifying clause in question. Furthermore, from the fact that this qualifying clause, as appears, was added after a personal interview with the Examiner at which Tufford had produced one of his commercial lifts for the Examiner's inspection (Rec. p. 255, near the bottom) it is apparent that this qualifying clause was drawn to define the three-point-contact form of lift, that is, applicant's commercial form which is the same as that shown in the drawing.

With regard to the second point above referred to, namely, the understanding of the patentee and the patent office as to what this qualifying clause meant when it was inserted, we call attention to the following parts of the patent office proceedings:

(4) Rec. pp. 256, 257, which shows that the Examiner refused to allow the claims, even with the qualifying clause inserted, because figure 2 of the drawing, as filed, did not show a three-point-contact heel. It will be seen that the Examiner analyzed figure 2, as it then stood, and held that all the points in the breast edge appeared to lie in a straight line passing through the two corner points whereas in the sample lift shown him at the interview "all the points of its breast except the two corner points lie below the straight line passing through these two points" (Rec. p. 257). And so the Examiner refused to allow the claims,—not because they were not in proper form but because the patentee's drawing, as he analyzed it, showed that one of the upper edges (the breast edge) was a straight edge whereas the claims, as he considered them, were for dipped or arched edges, thus forming a three-point-contact heel like the sample lift which had been shown to him. *This obviously left it to Tufford to change the drawing and accept the claims with the interpretation given to them by the Examiner or to stand for the broader construction which petitioner now insists on and appeal from the Examiner's ruling if the latter would not yield.*

(5) Rec. pp. 258, 259 and 260, which show that Tufford accepted the Examiner's view and changed the drawing to remove all traces of a straight-edge heel. Rec. pp. 257, 258, which show that, at the same time, an amendment was made to the specification to make the specification consistent with the change in the drawing. Rec. p. 258, which shows that an amendment was also

made to the claims striking out the words "tangent to" and inserting the words *passing through* because it was evidently thought more correct to speak of a plane passing through three points than as tangent to them.

Summarizing again, it appears from the file wrapper that the patent office was willing to allow claims to cover the patentee's commercial form of heel-lift, that is, one embodying the three-point-contact type and that to define this three-point-contact type the qualifying clause was inserted in the claims; but that the patent office was unwilling to have the claims issue until the drawing and specification had been so changed as to remove every suggestion that *any* upper edge of the heel-lift could be straight, *i. e.*, lie in the reference plane, as distinguished from being arched below that plane, thus showing that the patent office did not intend to grant claims 5 to 9 of the patent unless they were absolutely and strictly confined to the three-point-contact type; and that when this was done by the patentee's acceptance and compliance, said claims were allowed and the patent issued.

Authorities on File Wrapper Defense.

We would observe that this is not merely a case where the file wrapper proceedings in the Patent Office make clear how the language of the claims was understood by the patentee at the time they were allowed, but is a case where the patentee, in order to get the claims, was forced to amend his patent application so as to show clearly that the claims were granted with the limited and restricted meaning which the Examiner had imposed upon them.

If in the one case, it might be argued that the claims ought to be given as broad an interpretation as they will bear notwithstanding that at the time they were allowed they were thought to have a more restricted meaning, it cannot be so argued here where the patentee, as a condition precedent to allowance, acquiesced in the restricted meaning of the claims by changing his specification and drawing in response to the Examiner's insistence that without such change the claims would not be allowed.

One of the most recent patent cases cited by the Supreme Court involving the effect of acquiescence in the Patent Office is *Weber Electric Co.* v. *Freeman Electric Co.*, 256 U. S. 668. On page 677 of the opinion in that case, the Supreme Court said as follows (Itals. ours):

> "*Having thus narrowed his claim* against rotary movement *in order to obtain a patent, the patentee may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments, which amount to a disclaimer* of rotation as an operative feature of his device."

In another case, *Morgan Envelope Co.* v. *Albany Paper Co.*, 152 U. S. 425, the Supreme Court said at pp. 428 and 429 (Itals. ours):

> "the patentee having once presented his claim in that form, and the Patent Office having rejected it, and he having acquiesced in such rejection, he is, under the repeated decisions of this Court, now estopped to claim the benefit of his rejected claim *or such a construction of his present claim as would be equivalent thereto.*"

It does not make any difference in applying the principle of acquiescence, if an applicant for patent who amends his claim after rejection continues to maintain that the original claim, before amendment, was not met by the prior art cited in rejecting it and that his invention is really broader than the amended claim which the Examiner has insisted upon and which was made in pursuance of the Examiner's insistence. This last rule has been stated by Mr. Justice Taft when sitting as circuit judge in *Thomas* v. *Rocker Spring Co.*, 77 Fed. Rep. 420, as follows (Itals. ours):

> "We come now to the novel question presented in this case. It is argued, and the circuit court held, that because the applicants, after the rejection of the claim, and after inserting the required limitations in the specifications, protested that the examiner was wrong in rejecting the claims, and advised him that they proposed to insist on a construction of claims as amended to cover the same ground as the rejected claims, the ruling of the patent office is not to be given the same effect as it would otherwise have. It seems to be contended that an applicant

can qualify or minimize the effect of his acquiescence in the rejection of a claim by stating to the patent office that it is not an acquiescence, and that he expects to insist upon his right to cover the same ground as the rejected claim covered, under other and amended claims. We are clearly of opinion that he cannot thus destroy the effect of a patent office ruling. *If he dissents from it, he should appeal from the ruling.* In this case, if, as the applicants continued to assert in their letters to the patent office, they propose to claim that their invention covered spiral springs used in the platform rocking chairs, they should have carried the question of their right to do so on the occasion of the rejection of the specific claim therefor to the successive appellate tribunals in the patent office, and thence, if necessary, by appeal into court. Not having done so, they must be taken as having acquiesced in the rejection; there is no middle ground. Because of this acquiescence the patent of complainant cannot be construed to embrace any combination of spiral springs with the rockers of platform rocking chairs."

Claim 8.

Petitioner has heretofore made much of the fact that in claim 8 the word *rear* does not appear in the qualifying clause before the words "*upper edge*" and that while all of the claims in suit, except claim 8, specify that the concave upper face of the lift lies entirely below a plane passing through the *rear* upper edge and the breast corners of the lift, claim 8 specifies that this reference plane passes through the upper edge and breast corners, without stating *what part* of the upper edge it passes through. Petitioner argues from this that claim 8 must be construed to mean that the reference plane passes through the *entire* upper edge.

The Court of Appeals, passing on this contention, held as follows (Rec. p. 361):

> "The District Court has found that it clearly appears that a mistake was made both by the Examiner and the applicant in the omission of the word 'rear' before the words 'upper edge' in claim 8 of the reissue patent, and it has been strenuously argued before us that this was error as the court is without power to revise the plain, unambiguous language of the claim. That the claim must be read in the light of the specifications and drawings is too well established to need the citation of any authorities.
>
> Under R. S. sec. 4916 a reissue patent can only be granted for the same invention for which the original patent was granted. Mahn *v.* Harwood, 112 U. S. 354; Parker & Whipple *v.* Yale Clock Co., 123 U. S. 87. In the latter case the court said at page 98:

'Corrections may be made in the description, specification or claim where the patentee has claimed as new more than he had a right to claim, or where the description, specification or claim is defective or insufficient; but he cannot under such an application make material additions to the invention which were not described, suggested, nor substantially indicated in the original specifications, drawings, or patent office model.'

According to the original specification and drawings of the applicant the upper side edges of the entire concave surface of the Tufford lift do not lie in a plane passing through the breast corners and all the upper edges of the lift; and this was expressly disclaimed by the applicant's attorney. Claim 8 of the reissue patent without the word 'rear' before the words 'upper edge' is invalid because not for the same invention as described in the original specification and drawings and would have been so found by the Examiner had he not believed, as it clearly appears from the file wrapper he did, that the word 'rear' appeared in the claim before the words 'upper edge.'

While the defendant has admitted the validity of the patent it has in its answer alleged that the scope of the patent is limited by the proceedings in the Patent Office as shown by the file wrapper.

Construing the claim in the light of the specification and drawings, as well as of the proceedings in the Patent Office, we have no doubt that the words 'upper edge,' used in this claim, refer to the rear upper edge; for, if this were not so, the claim would be invaiid. The plaintiff's invention, therefore, is limited to a heel lift concavo-convex on every line of cross section, whose concave face lies entirely

below a plane passing through its two breast corners and rear upper edge and is not infringed by the defendant's heels."

The District Court reached the same conclusion, reasoning as follows (Rec. pp. 20-22*):

"It will be seen that each of these claims, with the exception of claim 8, contains a clause wherein the concave upper face is described as 'lying entirely below a plane passing through the rear upper edge and the breast corners of the 'lift'; and that in claim 8 the language of the claim is the same with the exception that the word 'rear' before 'upper edge' is omitted. It appears, however, from an examination of the file-wrapper of the reissued patent that the omission of the word 'rear' in the eighth claim was a clerical error due to oversight; that counsel for the applicant and the examiner in charge of the application understood that all these claims as drawn at the time they were allowed contained the word 'rear' preceding the words 'upper edge'. This appears from what will be found in the file-wrapper of the reissued patent beginning on Rec. p. 254 and extending to Rec. p. 260. On Rec. p. 257 the examiner says: 'In each of the claims 5, 6, 7, 8 and 9 applicant specifies 'that the concave upper face lies entirely below a plane tangent to the rear upper edge and the breast corners of the lift' and it there appears that these claims were rejected not because of the wording of the claims, but be-

*NOTE: In the above-quoted opinion of the District Court the references to the pages of the *exhibit* file wrapper have been changed to indicate the corresponding pages in the *printed* file wrapper in the present record.

cause of one of the drawings (Fig. 2) filed in the case. This drawing (Fig. 2) did not at that time conform to the shape of the plaintiff's heel and, because of that, the claims were disallowed as they would not read upon Fig. 2. The only change thereafter made in the claims as they then stood was the insertion of the words 'passing through' for 'tangent to' in the clause here in question, and to define the meaning of the clause as amended, Figure 2 having been changed to conform to the plaintiff's heel, the following provision was inserted in the specification:

> 'By references to Figs. 2 and 4 of the drawings, it will be seen that the concave upper face of the lift lies entirely below a plane passing through the rear upper edge and breast corners of the lift whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when the lift is positioned on the heel and the convex face thereof depressed to flatten said lift. In other words owing to the curvature of the concave attaching face of the lift, the rear upper edge and breast corners of said concave attaching face are disposed in a plane above the upper side edges and the breast edges of the lift.'

"This amendment in connection with new Figure 2 clearly shows that the plaintiff's heel was to have a rear upper edge and breast corners located 'above the upper side edges and the breast edges of the lift', and that the words 'passing through' meant a plane passing through the rear upper edge and breast corners and above the side and breast edges.

"The conclusion that the word 'rear' was omitted from the clause under consideration in claim 8 through inadvertence and was a clerical error is

further shown by the language used in the claim itself, for a plane passing through the upper edge, if upper edge meant the entire upper edge as in defendant's heel, would pass through the breast corners as well, and there would have been no occasion for stating in that clause that it passed through the breast corners. Then again, down to the time it was pointed out in the decision of the Court of Appeals of June 7, 1922, the plaintiff had always recognized that this clause in claim 8 read the same as it does in the other claims; that was its position before the District Court before the case was taken to the Court of Appeals; and has apparently been its position before other courts where these claims have been considered."

The face of the patent indisputably establishes that the clause in claim 8 defining the upper face of the lift with respect to the reference plane, refers to the same structure, namely, the three-point-contact structure shown in the drawing, to which the corresponding clause in each of the other claims in suit refers; for, if the clause in claim 8 had meant to imply that the reference plane passed through *all* of the upper edge, then it would have been superfluous for that clause to state that it also passed through the "breast corners", since, obviously, if the plane passed through all of the upper edge it would necessarily pass through the breast corners in which the upper edge terminates. Thus, the inclusion of the words "breast corners" shows conclusively that the words "upper edge" only refer to a portion of the upper edge.

If the words "upper edge" stood alone in the claim

there might be some ground for contention that all of the upper edge was meant; but by defining the plane as passing through the upper edge *and breast corners* as well, the claim itself supplies the internal evidence that only a part of the upper edge not adjacent to the breast corners was intended. This interpretation still leaves room for differentiation in the scope of the qualifying clause in both cases, since in the one case the portion of the upper edge through which the plane passes would be strictly limited to the rear upper edge whereas in the other case it might include a more extended portion.

The other internal evidence of the unsoundness of petitioner's contention is that claim 8, if interpreted as petitioner would have it, will not read upon the drawing nor accord with the specification. The drawing does not have its entire upper edge formed so that a plane could pass through it, and the specification particularly points out (line 101 *et seq.*, page 2 of the patent, printed in Rec. following page 164) that "the rear upper edge and breast corners of said concave attaching face are disposed in a plane above the upper side edges and the breast edge of the lift". One of the first canons of patent interpretation is that a claim must read upon the specification and drawing.

It is unnecessary therefore to look into the Patent Office proceedings to see what the Patent Office and patentee intended by the language used or to show that the word *rear* was omitted from claim 8 through the inadvertence and mutual mistake of the Examiner and the applicant. But if recourse is to be had to the Patent Office proceedings, it will be found that that is precisely

what did happen, as both the court of appeals and the district court below held. It will also be found that in the application for the original patent, of which the patent in suit is a reissue, claims were sought and rejected which called for "the edges of the attaching face all occupying the same plane" (Rec. p. 275, near the bottom). This was noted by both courts below in their opinions, and both courts held that by the cancellation of those claims, Tufford disclaimed any such form of heel-lift.

Claim 10.

This claim is not in issue; but petitioner has pointed out the difference between the language defining the reference plane in claims 5 to 9 and the language defining the reference plane in claim 10, arguing that unless different interpretations are based thereon, claim 10 will become the same as one or more of claims 5 to 9. But such contention overlooks the fact that claim 10 is differentiated from claims 5 to 9 in other respects than by the language defining the reference plane. Judge Bingham has pointed this out so clearly in the opinion in the District Court that we quote the same herewith (Rec. p. 26):

> "It has been argued before me that claims 5, 6, 7, 8 and 9 of the patent cannot be differentiated from claim 10, if the restricting clause of these claims is given the same meaning as the restricting clause in claim 10, and which the specification says means the same. I do not think this is so. Claim 5 is differentiated from all other claims in that it requires the heel lift to be of 'substantially non-metallic resilient material'. Claim 6 is differentiated by the heel being provided with 'nail receiving openings located near the center thereof'; claim 7 by the fact that the heel is 'normally held in such form by its own inherent resiliency'; claim 8 by the body portion of the heel being of 'uniform thickness throughout its entire area'; claim 9 by 'the concave face of the lift being unbroken.' Claim 10 is differentiated from claim 5 by the clause 'substantially resilient material' which is not necessarily non-metallic as in claim 5; from claim 6 by

not having nail receiving openings; from claim 7 by not being held in shape by its own inherent resiliency; from claim 8 by not being of uniform thickness throughout its entire area; and from claim 9 by not having its face limited to an unbroken concave face. Claims 5, 6 and 8 in express terms provide that the body portion of the heel shall be 'of concavo-convex form on every line of cross section'; claims 7 and 10 that the attaching face of the heel shall be 'concave and the tread face convex on every line of cross section'. Claim 7 also contains a whereby clause which states in substance that the elements of the claim are such as to cause the entire margin of the lift to exert a uniform pressure on the shoe heel when said lift is positioned on the heel, and the evidence shows that this uniform pressure can be obtained only in case the breast edge is raised, as well as the side and rear edges. This being so, it follows that the elements described in claim 7 call for a heel the concave face of which is concave on every line of cross section. And what is true of claim 7 is true of claim 10. Claim 9 does not use the term 'on every line of cross section' either as to the concave face or the convex tread, but contains a whereby clause in which it states that 'when the convex tread face is depressed to flatten said lift a suction will be created between the lift and the heel to hold the attaching face of the lift throughout its entire extent in contact with the exposed face of the heel'. While the language of this whereby clause is not the same as the whereby clause in claim 7, it means the same, and the evidence shows that the result here claimed can be produced only in case the breast is raised as well as the side and rear edges of the heel. Further-

more, if claims 7, 9 and 10 are not capable of this construction, they would seem to be invalid, as calling for a heel not disclosed in the specification."

This point was also dealt with in another case where the court disposed of it as follows (*I. T. S. Rubber Co.* v. *United Lace & Braid Mfg. Co.*, 266 Fed. Rep. 375, 379):

> "The argument that through a comparison with claim 10 the claims in suit are to be broadened, and to be so read as to exclude the side edges from the face, seems to me artificial and unsatisfactory, and to require that we should give different meanings to phrases which the specification uses as alternative descriptions of the structure showing the drawings. It does not seem to me essential to make this distinction in order to preserve the substance of the invention which Tufford made."

The Omission of a Metallic Plate.

In some of the suits brought under the Tufford patent, petitioner has argued that the omission of a metallic plate such, for example, as is shown in Nerger's patent, was itself an invention irrespective of anything else which Tufford did; and that Tufford's patent should be broadly construed so as to include all concavo-convex heels where the metallic plate has been omitted.

Even if it could be said that the omission of the plate was an invention by itself, still Tufford is clearly precluded from asserting that his present claims are drawn to cover that invention because he particularly asked for such claims when his application was pending in the Patent Office and when those claims were rejected upon Nerger he withdrew them. This appears in that portion of the file wrapper beginning on page 248 of the record. Beginning on the top of that page, it will be seen that certain claims were rejected upon Nerger's patent then cited by the Patent Office for the first time; and that, in the next amendment filed by Tufford, he cancelled the rejected claims and substituted four new ones numbered 5 to 8 inclusive, of which the following is typical:

> "5. A heel-lift of resilient material comprising a body portion of concave-convex form on every line of cross section *and normally held in such form by its own inherent resiliency.*"

The italicized clause in the claim of course refers to the omission of the plate which Nerger's heel had; for in the "Remarks" which Tufford submitted with these

new claims to support their patentability over Nerger's patent, he refers in the first two paragraphs to several disadvantages which he says Nerger's plate introduces. Then he says that he has overcome all of these objectionable features, that his lift is "devoid of spring or metal plates or other reinforcements" and is "retained normally in its concavo-convex form by the inherent resiliency of the lift only"; and that "by having applicant's lift devoid of metal plates and the like, not only is a greater suction produced but the margin of the heel may be trimmed to fit heels of different sizes * * * thus rendering it unnecessary for the shopkeeper to keep various sizes of heels constantly in stock."

To these remarks, the Patent Office Examiner replies (Rec. p. 252) refusing to concede that the omission of Nerger's plate amounted to invention and again holding that Nerger's patent meets the claims. The claims were accordingly rejected and Tufford was advised that he might "regard this rejection as final if he so desires." That meant that Tufford might appeal from the ruling that it was not invention to omit the metallic plate. But Tufford did not take an appeal. On the contrary, he cancelled the claims and inserted claims 5 to 9 of the patent which now form the basis of the present suit.

It may be pointed out additionally that the Court of Appeals for the Sixth Circuit and the Court of Appeals for the Seventh have both refused to hold that the omission of Nerger's plate in itself involved invention. *Tee Pee Rubber Co.* v. *I. T. S. Rubber* Co., 268 Fed. Rep. 250, 254; *U. S. Rubber Co.* v. *I. T. S. Rubber Co.*, 288 Fed. Rep. 786, 793.

Infringement.

In the present case, respondent is charged with infringement because of its manufacture of two different species of the concavo-convex type of heel-lifts; one, the closed-breasted species like those of "Plaintiff's Exhibit 1, Series A," and the other, the open-breasted species like those of "Plaintiff's Exhibit 2, Series B." Neither species has the three-point-contact feature and hence, if the patent is limited to the three-point-contact feature as both the District Court and the Court of Appeals have held, then neither the Series A nor the Series B heels infringe.

If the decisions of the Court of Appeals of the Sixth Circuit be followed in determining the scope of the patent, then the closed breasted type of Series A heels are infringements but the Series B heels, being open-breasted, are not infringements.

But if this court finds that each of claims 5 to 9 in suit is limited to a rubber heel-lift having its upper side edges arched so as to form a lift of the three-point-contact type, as was held by both courts below, then it is immaterial whether respondent's heels have an open breast or a closed breast; they do not infringe because their upper side edges lie all in one plane.

The Suction Test.

Many of the heels in evidence can be made to stick down to a smooth flat surface by suction; and plaintiff has endeavored to introduce this test as a criterion of infringement. If the heels stick down, plaintiff contends, this is evidence of the intensive sealing around the edges which the patent in suit contemplates and, therefore, such heels should be presumed to have the structure covered by the patent in suit and to be infringements.

The Court of Appeals in the Sixth Circuit has spoken of this alleged test of infringement as follows, *Tee Pee Rubber Co.* v. *I. T. S. Rubber Co.*, 268 Fed. Rep. 250, 256-7:

> "As shown by the opinion in this case, we reached the conclusion that the Tee Pee lifts did not have the peculiarly shaped surface, called saucer shape, which was characteristic of the Tufford invention, but had, rather, the scoop shape which served to classify them with the earlier Nerger device. This conclusion was fortified by observation of the samples submitted, and by certain manipulation by us of the exhibits, as recited. From these, we inferred that the Tee Pee lifts did not have that automatic, intensive sealing at the edges which was symptomatic of the Tufford invention, as we interpreted the claim under discussion. Upon application for rehearing, counsel for plaintiff now challenge the accuracy of the observation and experiments recited in the opinion, *and insist that they can, by experiment in open court, if permitted a reargument, demonstrate that the Tee Pee*

lifts will adhere by suction and will have this intensive sealing, even at the center of the breast edge.

Since counsel have not had the opportunity, we must, in passing on the rehearing petition, assume that they would be able to succeed in their proposed experiments; and, if what was said in the opinion on this subject were vital to the conclusion reached, a rehearing should be permitted. However, we do not regard it as vital."

The Court of Appeals for the Seventh Circuit, quoting the foregoing excerpt from the decision of the Court of Appeals for the Sixth Circuit, spoke as follows about the suction test, *United States Rubber Co.* v. *I. T. S. Rubber Co.*, 288 Fed. Rep. 786, 791:

"We assume that the terms as used are intended to express the pressure of the atmosphere against the exterior of a body that has a vacuum in its interior. Admittedly, when appellee's lift is flattened against a perfectly smooth surface, so smooth that, when the face of the rubber comes in close contact with it, no air can enter between the two surfaces, a vacuum exists in the interior, so that there is a resulting suction on the interior, and air pressing on the exterior. This is due to the air pressure, and to nothing else. It may result from a scoop-shaped object as well as a saucer-shaped one. Its existence all depends upon the existence of a vacuum.

Entirely different, in its source and cause, in our opinion, is the advantage of the Tufford lift's gripping power. That is due to the tendency of curved rubber to regain its shape when flattened. It certainly cannot be contended that a vacuum can be created by any of these lifts upon ordinary leather

heels. It is the gripping power on all its edges that distinguishes the Tufford from the Nerger and appellant's heels, not its suction, which is valueless as an operative element. *Such suction or sealing may or may not be a symptom of Tufford's lift. It may or may not be a symptom of appellant's lift.*"

We think the foregoing quotations leave nothing to be added by way of comment upon the alleged suction test.

The Interpretation Given to the Patent in the Sixth Circuit.

The litigation under the patent in suit was begun in the sixth circuit; and the Court of Appeals there filed its first two opinions on October 7, 1919. These opinions were in two suits which were argued together, namely, *Fetzer and Spies Leather Co.* v. *I. T. S. Rubber Co.*, 260 Fed. Rep. 939, and *United States Rubber Co.* v. *I. T. S. Rubber Co.*, 260 Fed. Rep. 947. In the first of those cases, the infringing heel was a very close copy of the heel illustrated in the patent itself, that is, was of the three-point-contact type; while in the second of those cases, the infringing heel had its upper side edges all in a single plane, like the upper side edges of respondent's heels here. In both of those suits, the validity of the patent was in issue and the principal defense against validity was based upon what a prior patentee, one Nerger, had and did.

The reported opinion in the Fetzer and Spies case states (260 Fed. Rep. 942, 943) that numerous witnesses were called to support Tufford's contention that his invention accomplished the results claimed for it; and, as appears, a very substantial quantity of evidence was introduced as the basis of the fact findings set forth in that opinion relative to the history, development, exploitation, commercial success and results of Tufford's invention.

In addition, it appears, that evidence was also introduced in that case of Nerger's prior activities; for in speaking of Nerger's patent, the court remarked (p. 940) that any uncertainty about what that patent disclosed

was removed "by the evidence as to what Nerger did". See also page 945, where the court refers to testimony in deposition form about the previous sale and use of Nerger's heel, etc. In short, there was substantial evidence in one or both of those suits tending to throw considerable light on what Nerger had and did prior to Tufford, beyond what Nerger's patent disclosed.

In the present suit there is no evidence bearing upon the history, development, exploitation, commercial success, etc., of Tufford's invention; neither is there any evidence, except the Nerger patent, of what Nerger had and did prior to Tufford. It is important to keep this in mind in considering the findings and conclusion of the Court of Appeals for the Sixth Circuit, because, as we shall show, that court was led to its conclusion regarding the scope of the Tufford patent by carefully comparing what the prior patentee, Nerger, had and did with what Tufford had and did.

Turning first then to paragraph numbered "2" of the opinion in the United States Rubber Co. case (260 Fed. Rep. 947), we find it stated that the infringing heel-lift in the Fetzer and Spies case was of the three-point-contact type, while that in the United States Rubber case had "the upper edge of the sides and rear all in the same horizontal plane". That opinion then proceeds to discuss the question, whether the phrase "the concave upper face lying entirely below a plane passing through the rear upper edge and the breast corners of the lift" confines the invention to the three-point-contact type or includes heel-lifts having their upper side and rear edges in the same horizontal plane.

In its discussion of this issue, the court refers to the specification of the patent and notes that in the specification there are two phrases defining the upper face of the lift in similar, though not identical, language and that those phrases are coupled to each other by the connective phrase "In other words" thus:

> "By references to Figs. 2 and 4 of the drawings, it will be seen that *the concave upper face of the lift lies entirely below a plane passing through the rear upper edge and breast corners of the lift* whereby to cause the entire margin of said lift to exert a uniform pressure on the heel of a shoe when the lift is positioned on the heel and the convex face thereof depressed to flatten said lift. *In other words,* owing to the curvature of the concave attaching face of the lift, *the rear upper edge and breast corners of said concave attaching face are disposed in a plane above the upper side edges and the breast edges of the lift.*" (Page 2 of the patent, lines 91-105; Rec. following, p. 164.)

The court in the sixth circuit, after thus alluding to the two descriptive phrases, decides the point as follows (p. 949):

> "The presence of this double and declaredly alternative use of the two phrases presents a serious question, and must challenge the rightfulness of the theory that they mean different things when found in the claims; but, in spite of this, we think the theory should be accepted. 'In other words' does not necessarily imply exact equality. The words are often used to connect thoughts which are similar, but not identical, *and to make them, in this case,*

> *a controlling declaration of identity, would be to permit what we think the substance of the invention, the advance which Tufford had made over Nerger, to be appropriated with impunity.* We will not unnecessarily give claims a construction leading to that result."

The result thus reached by the court in the sixth circuit, *on a record which contained full evidence of what Nerger had and did,* was that Tufford was the first to disclose a heel-lift concavo-convex *on every line of cross-section* and that "The reissued claims (claims 5-10) are limited *to the precise distinction from Nerger, viz., to a lift concavo-convex in all cross-sections*" (p. 947).

But the Patent Office, *which had no evidence before it of what Nerger had and did, except the Nerger patent,* did not reach that conclusion at all. It reached precisely the opposite conclusion; for it found that Nerger's lift *also* "has an upper surface concave on any line of cross-section and a tread surface concentric thereto" (Rec. p. 252). That is to say, the Patent Office held that Nerger's lift was concavo-convex on every line of cross-section. Thus, the very feature which the court in the sixth circuit found to distinguish Tufford's lift from Nerger's lift, the Patent Office found to be actually contained in Nerger's lift. Having so found, the Patent Office rejected Tufford's claims and advised him that the rejection might be regarded as final, if he so desired, which meant that Tufford might appeal (Rec. pp. 252-253); Tufford did not appeal but cancelled t rejected claims and inserted claims 5 to 9 which now form (with a very slight change) the claims in suit (Rec. pp. 253-254) and

which for the first time, in addition to reciting that the heels are "concavo-convex on every line of cross-section", also recite that "the concave upper face lies entirely below a plane tangent to the rear upper edge and breast corners".

And likewise, both courts below, having before them only what the Patent Office had so far as Nerger's lift was concerned, found identically with the Patent Office and therefore held that Tufford had not been allowed claims broad enough to include *all* lifts concavo-convex on every line of cross-section but, rightly or wrongly, had been required to amend his claims by including therein the phrase defining the location of the upper face and side edges with respect to a reference plane; and so concluded that respondent's heels with their upper side edges all in one plane did not infringe.

The court in the sixth circuit gave the name "saucer-shaped" to lifts concavo-convex on all lines of cross-section, to distinguish from the Nerger form which it called "scoop-shaped"; and in a later case, *Tee Pee Rubber Co.* v. *I. T. S. Rubber Co.*, 268 Fed. Rep. 250, the court in the sixth circuit made diagrams illustrating its use of these terms. But neither of the courts in the first circuit found it necessary to make this distinction because both of those courts held, as we have just seen, that as the result of the proceedings in the Patent Office, Tufford could not now maintain a monopoly of all heel-lifts concavo-convex on all lines of cross-section (saucer-shaped heels) and hence did not find it necessary, in determining the question of infringement, to distinguish between "saucer-shaped" and "scoop-shaped" lifts. Per contra, both

courts below found that by amending his claims when they were under rejection by the Patent Office so as to include the descriptive phrase defining the location of the upper face with respect to the reference plane, Tufford could not now successfully maintain that any heel-lifts having their upper side and rear edges all in one plane were infringements. And since all respondent's heels were of that type the bill was dismissed for non-infringement.

The Issue of Estoppel.

Petitioner charges in its bill of complaint, and has argued in both courts below, that respondent participated in the defense of certain prior infringement suits brought under the patent here in suit and is therefore estopped by the judgments in those suits to contest the validity and scope of said patent here.

Assuming that such issue is properly raised by the pleadings in this case, we submit that since petitioner has sought and obtained the writ bringing the case here, upon the ground that two circuit courts have differently interpreted the patent and that therefore this court should determine the scope of the patent for the whole country, it cannot consistently maintain, now that the case *is* here, that respondent cannot be heard upon the very matter which brought it here, namely, the scope of the patent.

Briefly, the facts upon which the estoppel is based are these: Respondent is a manufacturer of rubber heels with its plant and principal place of business in New Jersey, and sells to jobbers located in different parts of the country. Before the action in this case was brought, petitioner sued some of respondent's jobbers in the Middle West. Respondent was not a party to any of these suits and they were not defended. Eventually, *pro confesso* orders were taken therein and interlocutory decrees entered adjudging the patent valid and infringed and sending the cases to a master to take an account of the profits and damages. Respondent thereupon effected a settlement of the profits and damages,

the accountings were waived, final decrees were entered, and respondent paid the costs.

Both the district court and the court of appeals below held that respondent's conduct in these prior suits did not preclude it from contesting fully all patent issues raised by the pleadings in the present action.

If, now, petitioner insists that before these patent issues can be considered here there is an issue of estoppel to be determined by this court, that in effect will be to contend that no patent questions should be heard here on account of the previous conduct of the respondent.

It is submitted therefore that unless petitioner, who brought the case here by representing to this court that the scope of the patent *would be* open for settlement, is prepared to waive the alleged estoppel, this court ought to dismiss the petition as one in which the case, as developed, makes it appear that the writ was improvidently granted. *Furness & Co.* v. *Yang-Tsze Asso.*, 242 U. S. 430; *Layne & Bowler Corp.* v. *Western Well Works*, 261 U. S. 387; *Southern Power Co.* v. *North Carolina Pub. Ser.*, 263 U. S. 508.

The estoppel is pleaded in paragraph 6 of the bill of complaint printed at pages 2 to 6 of the record; and more than half the entire record is made up of evidence which relates to this issue of estoppel and nothing else. This evidence has been so carefully digested by Judge Bingham in the district court and his findings of fact so clearly stated, that we cannot do better here than quote Judge Bingham's summary and findings of fact. At least, we think this court will accept the fact findings of the trial judge so far as this issue is concerned. We therefore

quote from the opinion of the district court (Rec. pp. 15 to 20):

> "In view of the foregoing the plaintiff alleged that the Essex Rubber Company was estopped, by the decree in the Hackman case, to contest the issue of infringement in this case as to heels like Exhibit No. 1, Series A, and by the decree in the Urbansky case to contest that issue as to heels like Exhibit 1, Series A, and Exhibit 2, Series B.
>
> "In support of its allegations as to the Hackman matter it appeared that Hackman & Co. were dealers in rubber heels and had purchased heels from the Essex Rubber Company like those here in question. The plaintiff introduced a certified copy of the record in that suit, which comprised a bill of complaint charging infringement of the plaintiff's patent by the sale of Essex Tite-Edge heels like Exhibit 1, Series A, a motion for a preliminary injunction, a portion of a decree granting a preliminary injunction, a decree styled a final decree, but in fact being only an interlocutory decree *pro confesso*, as it referred the case to a master to ascertain, state and report to the court an account of the damages and profits due to infringing the plaintiff's exclusive rights. The record does not show that Hackman & Co. appeared in the case or filed an answer or that anyone else appeared and filed an answer either in Hackman & Co.'s behalf or in behalf of themselves; and as the record fails to show that a final decree was entered, it necessarily follows that neither Hackman & Co. nor the defendant here is estopped by the interlocutory decree *pro confesso*. McGourkey *v.* Toledo & Ohio Ry., 146 U. S. 536, 545; Smith *v.* Vulcan Iron Works, 165 U. S. 518, 524; Humiston *v.* Stainthorp, 2 Wall. 106; Australian Knitting Co. *v.*

Gormley, 138 Fed. 92, 100, and cases there cited. This renders it unnecessary to consider whether the Essex Rubber Company could, in any view, be regarded as a party to the cause and bound by a decree therein if a final decree had been entered. But I find that the Essex Rubber Company did not defend or control the suit; that on being notified by Hackman & Co. of the bringing of the suit it replied that it would not defend it but would reimburse them, in case they concluded not to defend, for damages that might be recovered against them; and that Hackman & Co. replied that they had no intention of defending the suit.

"As to the Urbansky matter it appeared that Thomas Urbansky & Sons Co. were also dealers in heels purchased from the Essex Rubber Company, and the plaintiff introduced a certified copy of the record in that case, comprising a bill of complaint charging infringement of plaintiff's patent by the sale of Essex Tite-Edge heels, a motion for preliminary injunction, an interlocutory decree pro confesso directing a reference to a master for an accounting, an order fixing the compensation of the master and stenographer and directing that the same be taxed as costs, and an order stating that, as a settlement had been made of all claims for profits, the reference to the master was withdrawn, the interlocutory decree made final, and the plaintiff was to pay all costs. There is nothing in the record that shows anyone filed an appearance or answer in that case for the defendant or took any action in its behalf. The inference to be drawn from the record is that, after the case was sent to the master, before whom it was necessary for the complainant (the present plaintiff) to adduce evidence showing what

its damages were, the plaintiff procured an agreement with Thomas Urbansky & Sons Co. as to the amount due it, obtained satisfaction thereof, and then had an order entered making the interlocutory decree pro confesso final without having any sum adjudged due it as damages, but ordering that the costs incurred be paid by itself.

"The deposition of Thomas J. Urbansky, vice-president and secretary of the Urbansky Company, was introduced in evidence. In it he testified that after the suit was brought against his company he wrote to the Essex Rubber Company that they had been sued and that the Essex Company replied advising the Urbansky Company to let the matter go by default and it would reimburse them for the expense they were put to; that if this request had been contrary to their own interests they would not have acquiesced in it; that neither the Essex Company nor anyone representing them took any part in the conduct of the litigation; that all the Essex Company did was to reimburse them for what they paid out; that he personally arranged the settlement with Mr. Fales, attorney for the plaintiff; that Fales undertook to make him account for damages and profits from the sale of other types of heels in addition to the Tite-Edge; that the Essex Company reimbursed him but that he did not rely upon its promise to do so, as the expense was small and it would have been the same anyway because that company had not undertaken to protect his company against any losses when the goods were purchased. The correspondence between the Urbansky Company and the Essex Company shows that the latter advised the former that it would stand behind its jobbers and pay any judgment which might be obtained against them by

reason of any infringement caused by the handling or sale of its goods; that what The I. T. S. Rubber Company was suing its jobbers for was to compel it to submit its case to the courts out in Cleveland, but that it did not propose to do that, as it had its disadvantages. The deposition of E. D. Fales, a member of the firm of Richey, Slough & Fales, counsel for the plaintiff in this suit, was introduced in evidence and related to the matter now under consideration. Mr. Fales had charge of the Hackman and Urbansky suits as counsel for the plaintiff, and, after taking the depositions of Mr. Urbansky and others in this suit, gave his own deposition. Fales testified that Urbansky told him that the Essex Company had agreed to reimburse his company and that his company was conducting the case subject to the direction and suggestions of the Essex Company, and was doing nothing otherwise. But the correspondence introduced through these witnesses shows that Urbansky made the settlement with the plaintiff without any direction or suggestion from the Essex Company and that all the Essex Company did was to reimburse him after it was notified of the settlement.

"Taking into consideration all the evidence in the case, I find, as a fact, that the Urbansky Company of its own accord permitted the suit to go by default and adjusted and settled the matter of accounting after the interlocutory decree *pro confesso* was entered; that the final judgment made no award of damages, as they had been adjusted and settled by Urbansky out of court; and that the Essex Company did not control the disposition of the case either openly or otherwise. And I rule that the Essex Company is not estopped by the decree in the Urbansky case to contest the question whether heels

like Exhibit 1, Series A, and Exhibit 2, Series B, infringe the claims here in issue.

"In the suit against Wendt & Co. F. O. Richey and E. D. Fales were the counsel, and Campbell, Bulkley & Ledyard were the solicitors for the plaintiff. The record in that case consists of a bill in equity charging the defendant with infringement of the claims here in issue by the sale of Essex Tite-Edge heels like Exhibit 1, Series A; the affidavit of John G. Tufford; the affidavit of Frank M. Slough; an order entered May 3, 1920, to take the bill *pro confesso*, no appearance having been entered on the part of the defendant or answer or other pleading filed, although they should have been on or about the 26th of April, 1920; a copy of an order filed April 1, 1920, directing Wendt & Co. to appear on the 19th of April, 1920, and show cause why an injunction should not issue as prayed for in the bill; an interlocutory decree *pro confesso* entered June 17, 1920, appointing a commissioner to ascertain, take and state an account, and adjudging that the plaintiff on such accounting should have the right to cause the examination of the defendant, his associates, clerks, servants, workmen and other employees, and the production of books, vouchers and documents of such defendant, and that such defendant attend before the master, and awarding a perpetual injunction and costs; a copy of the perpetual injunction filed June 24, 1920; a stipulation filed November 1, 1920, signed September 13, 1920, by F. O. Richey and E. D. Fales as counsel for the plaintiff, and Angell & Turner for the defendant, in which it was stipulated that the defendant would pay at once to the plaintiff one thousand dollars in cash, that the plaintiff would accept the one

thousand dollars in lieu of profits and damages and that no appeal should be taken from the final decree of the court in the case; a copy of a final decree entered November 1, 1920, reciting that the defendant, having made settlement of all claims and profits for the sum of one thousand dollars, the reference to the master was withdrawn, and the plaintiff recover of the defendant the sum of one thousand dollars and the order for an accounting be withdrawn. It further recited the matters set out in the interlocutory decree *pro confesso* as to validity and infringement.

"The record in the Jones & Rosser suit differs in no material respect from the facts shown in the record in the Wendt suit. Both suits were begun at the same time; the patent relied on by the plaintiff in each was the same; the heels charged to be infringements were the same, and the orders taking the bills *pro confesso*, the interlocutory decrees *pro confesso* were of the same character and the respective dates at which they were entered up were the same. As to both matters it appears that Wendt, on April 7, 1920, and Jones & Rosser on April 12, 1920, notified the Essex Rubber Company of the commencement of the suits by The I. T. S. Rubber Company against them, and that the orders to show cause why a temporary injunction should not issue were returnable April 19, 1920, that the Essex Company, being unaware of what heels the plaintiff was relying upon in these suits as infringements, arranged, through Angell & Turner, attorneys in Detroit, to procure, if possible, a postponement of the hearings on temporary injunction so that it might have an opportunity to examine the exhibits and determine whether it desired to appear

and defend; for, if the heels relied upon as infringements included the new type of heel which it was manufacturing, it desired to appear and defend, otherwise not; that Angell & Turner conferred with plaintiff's local counsel, who agreed to a postponement as the plaintiff was desirous of having the Essex Rubber Company appear and defend the suits in that district; that the infringing heels relied upon in the two suits were produced for the examination of New York counsel representing the Essex Company, who, after examining the heels and ascertaining that they did not include the Essex Company's new type of heel, on April 28, 1920. wrote plaintiff's counsel that the Essex Company would not appear and, on April 29, 1920, they wrote Angell & Turner, who also informed plaintiff's counsel that the Essex Company did not wish to appear; that, no appearances having been entered and no answers filed in either case, orders taking the bill *pro confesso* were entered May 3, 1920, and that on June 17, 1920, interlocutory decrees *pro confesso* were entered in both suits; that in July, 1920, the defendants having been ordered to account and the Essex Company being informed of this and having previously written Wendt and Jones & Rosser that they would reimburse them for any losses they sustained by reason of suits, suggested to Wendt and Angell & Turner that they procure an adjustment of the damages and profits in the respective suits; that Wendt and a representative of the firm of Angell & Turner, having ascertained about what the plaintiff would be entitled to recover as damages and profits in the respective suits, proposed a settlement of a thousand dollars and costs in the Wendt suit and two hundred dol-

lars and costs in the Jones & Rosser suit, which were accepted by the plaintiff and final judgments *pro confesso*, based upon these agreements and the interlocutory decrees were entered; that Wendt paid the judgments in the respective suits and was reimbursed by the Essex Company.

"Down to the time of the entry of the interlocutory decrees *pro confesso* and the issuing of the notices to the respective defendants to appear and account, I find that the Essex Company did not exercise control over the management and conduct of the suit; that the respective defendants allowed them to go by default of their own free will, and that the plaintiff had no reason to understand or believe that it was managing or conducting the cases.

Rule 16 in equity provides:

> 'It shall be the duty of the defendant, unless the time shall be enlarged, for cause shown, by a judge of he court, to file his answer or other defense to the bill in the clerk's office within the time named in the subpoena as required by rule 12. In default thereof the plaintiff may, at his election, take an order as of course that the bill be taken *pro confesso*, and thereupon the cause shall be proceeded in *ex parte*.'

"When the orders and interlocutory decrees *pro confesso* were entered, the cases thereupon, as required by the above rule, proceeded *ex parte*. Threafter neither Wendt & Co. nor Jones & Rosser, nor anyone else, had any right to appear and never did appear as a party in defense of either suit. *Frow* v. *De La Vega*, 15 Wall. 522, 554; *Thomson* v. *Worcester*, 114 U. S. 104, 119. And when Wendt &

Co. and Jones & Rosser went before the master in response to his summons to account, they did so as witnesses in the plaintiff's behalf and in no other way. And the fact that the Essex Company co-operated with Wendt and Jones & Rosser through Angell & Turner to bring about adjustments of the damages and profits, which adjustments were used by the plaintiff, in place of the master's findings, as a basis upon which, in part at least, to obtain the final decrees, does not seem to me to be such an exercise of control of the cases as would make the Essex Company a party defendant, even though the plaintiff understood that Angell & Turner represented the Essex Company as well as Wendt and Jones & Rosser in adjusting the damages and profits.

"Before the damages were adjusted the issue of infringement upon which the plaintiff here relies had been decided by the court and embodied in the *pro confesso* decrees (*Thomson* v. *Worcester*, 114 U. S. 104, 113), and, although these decrees did not become binding as an estoppel until the entry of the final decrees and the expiration of the term at which they were entered (*L. E. Waterman Co.* v. *Modern Pen Co.*, 193 Fed. 242, 243), no one sought or procured leave to appear as a party or to in any way interrupt the *ex parte* course which the cases were to take under he rule. After the entry of the *pro confesso* decrees and as long as they stood unrevoked, Wendt & Co. and Jones & Rosser were absolutely barred and precluded from alleging anything in opposition to or in derogation of them, and, as the decrees were never revoked, they were bound by them as to the question of infringement from the date of their entry. *Thomson* v. *Worcester*, 114 U. S. 104, 114.

> Under the circumstances I find that the Essex Company did not control either the Wendt or Jones & Rosser suits, and rule that they are not estopped from contesting the question of infringement raised in this case."

In the court of appeals, the principal point relied upon by petitioner in respect of the issue of estoppel was that the attorneys (Angell and Turner of Detroit) hired and paid by the respondent here, put their names to the final decree in the Jones & Rosser suit (Rec. p. 178) and to a stipulation for final decree in the Wendt suit (Rec. p. 193), petitioner arguing that that of itself was such a participation by respondent in each of those cases as to bar respondent's right to litigate any of the issues settled by those decrees.

As already noted in the quoted portion of Judge Bingham's opinion, Angell & Turner were retained by respondent's New York counsel to get information as to what heels those two suits involved and to get a postponement of a motion for preliminary injunction in one of the suits. Angell & Turner had no authority to enter any appearances nor to take any action whatever in those suits except to seek an adjournment. They were fully instructed that the respondent did not wish to defend unless respondent's new form of lift was to be made the basis of a charge of infringement. As soon as respondent's New York counsel could get out to Detroit and ascertain that the new form of respondent's heels was not involved, Angell & Turner were promptly notified that respondent would not defend but would allow the cases to go by default (Rec. p. 155). And the

Detroit counsel were asked to notify respondent's New York counsel when any accounting proceedings were brought on in pursuance of the interlocutory decrees entered (Rec. p. 155). This was during the month of April, 1920; thereafter nothing occurred until the middle of July, 1920, when the following letter was addressed to one of the Detroit firm of attorneys by one of respondent's New York attorneys (Rec. p. 154).

"New York, July 7, 1920.

Dear Judge Angell:

I understand that Mr. Wendt has been ordered to account to the I. T. S. Company in the Heel litigation and that he has communicated with you in the matter. Will you please advise him on this accounting?

For your information I may say that the Essex Rubber Company has now been sued by the I. T. S. Company in Boston and the matter will be fought out there. I suggest therefore, that you get as long a postponement as possible on this accounting. We will probably communicate with you further.

Very truly yours,

MANVEL WHITTEMORE."

At this time Wendt had no longer the status of a party to the suit but was merely a witness summoned to give a deposition on the accounting. He was however entitled to counsel; and respondent here, having agreed to pay whatever was recovered on the accounting, was also entitled to have a legal representative attend the proceedings and advise the witness. The instructions given to the Detroit attorneys were in no

way inconsistent with the issues settled by the *pro-confesso* decrees. No attempt was made to reopen or upset those decrees. The only question left open and of interest to either party was the *amount* of recovery. Had the Detroit attorneys attempted to reopen the decrees or do anything in derogation thereof, that would have necessitated other instructions and further authority.

The Detroit attorneys replied on July 15 that "it might be advisable to settle on some basis." (Rec. p. 153.) The New York attorneys wrote on July 20 suggesting that $1,000 be offered (Rec. p. 152) and this was done (Rec. p. 150). On July 26, the Detroit attorneys asked to be advised if they should take any action in the accounting in the Jones & Rosser suit as to which they had been approached by a Mr. Wicker who had been handling that matter as attorney for Jones & Rosser (Rec. p. 152); and the Detroit attorneys were accordingly advised to handle both of these accountings together (Rec. p. 151). On September 8, the Detroit attorneys wrote that plaintiff desired to settle both cases for $1,000 a case (Rec. pp. 150-1). The New York counsel replied to settle the Wendt case at that figure (Rec. p. 150), and finally on October 1, Detroit counsel wrote that a settlement of the Wendt case for $1,000 had been agreed to, that Mr. Wendt had given a check for that amount, but that the costs still remained to be settled for (Rec. p. 150). On November 1, the Detroit attorneys wrote that they had arranged a settlement in the Jones & Rosser case for $200 and costs and that a stipulation to that effect had been signed and entered (Rec. p. 147).

That correspondence tells the whole story. It explains exactly what took place,—what led up to the approval of the final decree by the Detroit attorneys in the Jones & Rosser case and to the signing of the stipulation for the final decree in the Wendt case. We have recited all of the instructions which were given to the Detroit attorneys and everything the Detroit attorneys did. It would be pushing technicalities beyond the limit to hold that because these Detroit attorneys attached their signatures to the papers in question merely to approve the settlement that had been reached in each case,—the only thing they had authority to approve—can now deprive the respondent here of its day in court. So long as the interlocutory decrees required no approval whatever on the part of this respondent, or anybody else, save only in respect of such matters as were left open for settlement, any formal signatures appearing on the final decrees and purporting to approve the same, or to consent to their entry, relate only to such matters as were left open and needed approval and consent for the purpose of entry.

Summarizing then: The moment petitioner got its decrees *pro confesso*, it was entitled to proceed to final decrees. To do so, it started accounting proceedings. Settlements were made and the accountings waived. Petitioner did not need the approval of anybody in order to enter final decrees except in so far as these decrees evidenced the amount of recovery set forth therein which had been agreed upon. To evidence this agreement on the amount of the recovery, the Detroit attorneys signed their names,—to the final decree in one case and to the stipulation for the final decree in the other case. Their approval and consent to anything else was mere sur-

plusage and even if given, would have been wholly beyond their authority to give. Petitioner never at any time believed that respondent was attacking the interlocutory decrees.

This court has recently (January 11, 1926) handed down an opinion involving a similar question of estoppel but on a different state of facts. *Independent Wireless Telegraph Co.* v. *Radio Corporation of America,* No. 87, October Term, 1925. In that case, the court was dealing with the effect of a decree on a party beyond the reach of process who, though a necessary party had declined to take part in the case though he knew of its imminent pendency and of his *obligation to join;* and in deciding the point, this court referred to the prior case of *American Bell Telephone Co.* v. *National Telephone Co.,* 27 Fed. Rep. 663. In both of those cases, one of the controlling factors was the existence of an obligation binding the party to join in litigation against its licensees—the litigation which had resulted in the decree sought to be enforced aganst it. In the present case, there were neither licensees nor obligations to defend. Respondent never agreed to *defend* the suits against its jobbers and was under no obligation to do so. Moreover, those suits could be prosecuted to a conclusion without the necessity of joining the respondent. Furthermore, respondent never at any time participated in the defense of the suits against its jobbers and hence never voluntarily made itself a party thereto, as the defendant did in the case of *American Bell Telephone Co.* v. *National Telephone Co.* It seems clear, therefore, that there is nothing in the decision of this court in the Independent Wireless case that can be applied to the present situation.